



This document is scheduled to be published in the Federal Register on 01/06/2012 and available online at <http://federalregister.gov/a/2011-33815>, and on FDsys.gov

[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Parts 1 and 3

[Docket No.: PTO-P-2011-0074]

RIN 0651-AC68

Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act

AGENCY: United States Patent and Trademark Office, Commerce

ACTION: Notice of proposed rulemaking.

SUMMARY: The United States Patent and Trademark Office (Office) proposes changes to the existing rules of practice to implement the inventor's oath or declaration provisions of the Leahy-Smith America Invents Act. The Office proposes to revise and clarify the rules of practice relating to the inventor's oath or declaration, including reissue oaths or declarations, assignments containing oath or declaration statements from inventors, and oaths or declarations signed by parties other than the inventors. In order to better

facilitate processing of patent applications, the Office further proposes to revise and clarify the rules of practice for power of attorney and prosecution of an application by an assignee.

DATES: Written comments must be received on or before [Insert date 60 days after publication in the FEDERAL REGISTER].

ADDRESSES: Comments should be sent by electronic mail message over the Internet addressed to: oath_declaration@uspto.gov. Comments may also be submitted by mail addressed to: Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, marked to the attention of Hiram H. Bernstein, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy.

Comments may also be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal.

Although comments may be submitted by postal mail, the Office prefers to receive comments by electronic mail message over the Internet because sharing comments with the public is more easily accomplished. Electronic comments are preferred to be submitted in plain text, but also may be submitted in ADOBE® portable document

format or MICROSOFT WORD® format. Comments not submitted electronically should be submitted on paper in a format that facilitates convenient digital scanning into ADOBE® portable document format.

The comments will be available for public inspection at the Office of the Commissioner for Patents, currently located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Comments also will be available for viewing via the Office's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Hiram H. Bernstein ((571) 272-7707), Senior Legal Advisor, or Eugenia Jones ((571) 272-7727), Senior Legal Advisor, or Terry J. Maciejewski ((571) 272-7730), Technical Writer-Editor, Office of Patent Legal Administration, Office of the Associate Commissioner for Patent Examination Policy.

SUPPLEMENTARY INFORMATION: The Leahy-Smith America Invents Act was enacted into law on September 16, 2011. See Pub. L. 112-29, 125 Stat. 284 (2011). Section 4 of the Leahy-Smith America Invents Act amends 35 U.S.C. 115 and 118 to change the practice regarding an inventor's oath or declaration. Section 20 of the Leahy-Smith America Invents Act amends 35 U.S.C. 116, 184, 251, and 256 (and other statutes) to remove the "without any deceptive intention" provision. This notice proposes changes

to the rules of practice to implement the provisions of Section 4 of the Leahy-Smith America Invents Act and the changes in Section 20 of the Leahy-Smith America Invents Act that relate to the removal of the “without any deceptive intention” language from 35 U.S.C. 116, 184, 251, and 256.

More specifically, Section 4(a) of the Leahy-Smith America Invents Act amends 35 U.S.C. 115 to change the requirements for an inventor’s oath or declaration.

35 U.S.C. 115(a) provides that an application filed under 35 U.S.C. 111(a) or that commences the national stage under 35 U.S.C. 371 must include, or be amended to include, the name of the inventor for any invention claimed in the application.

35 U.S.C. 115(a) also provides that, except as otherwise provided in 35 U.S.C. 115, each individual who is the inventor or a joint inventor of a claimed invention in an application must execute an oath or declaration in connection with the application.

35 U.S.C. 115(b) provides that an oath or declaration under 35 U.S.C. 115(a) must contain statements that the application was made or was authorized to be made by the affiant or declarant, and the individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application. There is no longer a requirement in the statute that the inventor must state his country of citizenship and that the inventor believes himself or herself to be the “first” inventor of the subject matter (process, machine, manufacture, or composition of matter) sought to be patented.

35 U.S.C. 115(c) provides that the Director may specify additional information relating to the inventor and to the invention that is required to be included in an oath or declaration under 35 U.S.C. 115(a).

35 U.S.C. 115(d)(1) provides that, in lieu of execution of an oath or declaration by an inventor under 35 U.S.C. 115(a), the applicant for patent may provide a substitute statement under the circumstances described in 35 U.S.C. 115(d)(2) and such additional circumstances as the Director specifies by regulation. The circumstances set forth in 35 U.S.C. 115(d)(2) in which the applicant may provide a substitute statement are limited to the situations where an individual is unable to file the oath or declaration under 35 U.S.C. 115(a) because the individual is deceased, under legal incapacity, or cannot be found or reached after diligent effort, or an individual is under an obligation to assign the invention but has refused to make the oath or declaration required under 35 U.S.C. 115(a). Therefore, while an assignee, an obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter may make an application for patent as provided for in 35 U.S.C. 118, an oath or declaration (or an assignment containing the required statements) by each of the inventors is still required, except in the circumstances set forth in 35 U.S.C. 115(d)(2) and in any additional circumstances specified by the Director in the regulations. The contents of a substitute statement are set forth in 35 U.S.C. 115(d)(3). Specifically, the substitute statement must identify the individual to whom the statement applies, set forth the circumstances for the permitted basis for filing the substitute statement in lieu of the oath or declaration under 35

U.S.C. 115(a), and contain any additional information, including any showing, required by the Director.

35 U.S.C. 115(e) provides for making the statements required under 35 U.S.C. 115(b) and (c) in an assignment of record and specifically permits an individual who is under an obligation of assignment of an application to include the required statements in the assignment executed by the individual, in lieu of filing the statements separately.

35 U.S.C. 115(f) provides that a notice of allowance under 35 U.S.C. 151 may be provided to an applicant only if the applicant has: (1) filed each required oath or declaration under 35 U.S.C. 115(a); (2) filed a substitute statement under 35 U.S.C. 115(d); or (3) recorded an assignment meeting the requirements of 35 U.S.C. 115(e). 35 U.S.C. 111(a)(2), however, continues to require that an application filed under 35 U.S.C. 111(a) include an oath or declaration as prescribed by 35 U.S.C. 115, and 35 U.S.C. 111(a)(3) continues to permit the oath or declaration to be submitted after the filing date of the application, but within such period and under the conditions prescribed by the Director, including payment of a surcharge. Likewise, 35 U.S.C. 371(c) continues to require an oath or declaration complying with the requirements of 35 U.S.C. 115 for an international application to enter the national stage, and 35 U.S.C. 371(d) continues to require the oath or declaration to be submitted within the period prescribed by the Director, and with the payment of a surcharge if required by the Director and not submitted by the date of the commencement of the national stage. Thus, the change to 35 U.S.C. 115 does not alter the statutory authorization in 35 U.S.C.

111(a) and 371 for requiring the oath or declaration to be submitted prior to examination of the application, and requiring a surcharge for the submission of an oath or declaration after the filing date of the application under 35 U.S.C. 111(a) or by the date of the commencement of the national stage in an international application entering the national stage under 35 U.S.C. 371.

35 U.S.C. 115(g)(1) provides that the requirements under 35 U.S.C. 115 shall not apply to an individual named as the inventor or a joint inventor in an application that claims benefit under 35 U.S.C. 120, 121, or 365(c) of an earlier-filed application, if: (1) an oath or declaration meeting the requirements of 35 U.S.C. 115(a) was executed by the individual and was filed in connection with the earlier-filed application; (2) a substitute statement meeting the requirements of 35 U.S.C. 115(d) was filed in connection with the earlier-filed application with respect to the individual; or (3) an assignment meeting the requirements of 35 U.S.C. 115(e) was executed with respect to the earlier-filed application by the individual and was recorded in connection with the earlier-filed application. 35 U.S.C. 115(g)(2) provides that the Director may still require a copy of the executed oath or declaration, the substitute statement, or the assignment filed in connection with the earlier-filed application to be filed in the later-filed application.

35 U.S.C. 115(h)(1) provides that any person making a statement under 35 U.S.C. 115 may withdraw, replace, or otherwise correct the statement at any time.

35 U.S.C. 115(h)(1) also provides that if a change is made in the naming of an inventor requiring the filing of one or more additional statements, the Director shall establish

regulations under which such additional statements may be filed. 35 U.S.C. 115(h)(2) provides that if an individual has executed an oath or declaration meeting the requirements of 35 U.S.C. 115(a) or an assignment meeting the requirements of 35 U.S.C. 115(e), then the Director cannot require that individual to subsequently make any additional oath, declaration, or other equivalent statement in connection with the application or any patent issuing thereon. 35 U.S.C. 115(h)(3) provides that a patent shall not be invalid or unenforceable based upon the failure to comply with a requirement under this section if the failure is remedied as provided under 35 U.S.C. 115(h)(1).

35 U.S.C. 115(i) provides that any declaration or statement filed pursuant to 35 U.S.C. 115 must contain an acknowledgement that any willful false statement made in the declaration or statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than 5 years, or both. This is similar to the provision in current 37 CFR 1.68.

Section 4(a)(2) of the Leahy-Smith America Invents Act amends 35 U.S.C. 121 to eliminate the sentence that provided for the Director to dispense with the signing and execution of an oath or declaration or equivalent statement by the inventor in a divisional application when the divisional application is directed solely to subject matter described and claimed in the original application as filed. This amendment to 35 U.S.C. 121 is consistent with 35 U.S.C. 115(g)(1) because the inventor named in a divisional application would not need to execute an oath or declaration or equivalent statement for the divisional application regardless of whether the divisional application is directed solely to subject matter described and claimed in the original application.

Section 4(a)(3) of the Leahy-Smith America Invents Act amends 35 U.S.C. 111(a) to insert “or declaration” after “and oath.”

Section 4(b)(1) of the Leahy-Smith America Invents Act amends 35 U.S.C. 118 to change the practice regarding the filing of an application by a person other than the inventor. First, 35 U.S.C. 118 is amended to provide that a person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. Second, 35 U.S.C. 118 is amended to provide that a person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of, and as agent for, the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties. Finally, 35 U.S.C. 118 is amended to provide that if a patent is granted on an application filed under 35 U.S.C. 118, the patent shall be granted to the real party in interest. Under amended 35 U.S.C. 118, the Director may continue to provide whatever notice to the inventor that the Director considers to be sufficient.

The changes to 35 U.S.C. 115 and 118 do not mean that a person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent in all circumstances. They do, however, recognize that an assignee or a person to whom the inventor is obligated to assign can execute the oath or declaration. In those circumstances set forth in 35 U.S.C. 115(d)(2), an assignee or person to whom the

inventor is under an obligation to assign, or a legal representative of the dead or legally incapacitated inventor, is the applicant as is currently set forth in 37 CFR 1.41(b).

Section 4(b)(2) of the Leahy-Smith America Invents Act includes a conforming amendment to 35 U.S.C. 251 to provide for the filing of a reissue application by an assignee of the entire interest if the application for the original patent was filed by the assignee of the entire interest.

Section 4(c) of the Leahy-Smith America Invents Act amends 35 U.S.C. 112 to change, inter alia, the undesignated paragraphs to subsections. Section 4(d) makes conforming amendments to 35 U.S.C. 111(b) to make reference to the subsections of 35 U.S.C. 112.

Section 4(e) of the Leahy-Smith America Invents Act provides that the amendments made by Section 4 shall take effect on September 16, 2012, and shall apply to any patent application filed on or after September 16, 2012.

Section 20 of the Leahy-Smith America Invents Act amends 35 U.S.C. 116, 184, 251, and 256 to eliminate the “without any deceptive intention” clauses from each portion of the statute. This change should not be taken as an endorsement for applicants and inventors to act with “deceptive intention” in proceedings before the Office. As discussed previously, 35 U.S.C. 115(i) requires that any declaration or statement filed pursuant to 35 U.S.C. 115 must contain an acknowledgement that any willful false

statement made in the declaration or statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than 5 years, or both.

Section 20(l) of the Leahy-Smith America Invents Act provides that the amendments made by Section 20 shall take effect on September 16, 2012, and shall apply to proceedings commenced on or after September 16, 2012.

General discussion regarding implementation: 35 U.S.C. 115 as amended permits the required inventor statements to be made in an oath or declaration under 35 U.S.C. 115(a), a substitute statement under 35 U.S.C. 115(d), or an assignment under 35 U.S.C. 115(e). Since 35 U.S.C. 115 no longer contains a requirement that the inventor identify his country of citizenship, the Office will no longer require this information in the oath or declaration. The other requirements for oaths or declarations currently provided in 37 CFR 1.63 would be retained.

In view of 35 U.S.C. 115(d), the Office is proposing to permit an assignee, a party to whom the inventor is legally obligated to assign the invention, and a party who otherwise has a sufficient proprietary interest to provide a substitute statement with respect to an inventor who is deceased, is legally incapacitated, cannot be found or reached after diligent effort, or refuses to sign the oath or declaration, even when there are other inventors who are signing the oath, declaration, or assignment with the required statements. This would provide an alternative to the current procedure in which a legal representative (e.g., executor, administrator, guardian, or conservator) must sign the oath

or declaration for a deceased or legally incapacitated inventor, and, if joint inventors are signing the oath or declaration, the joint inventors must sign the oath or declaration on behalf of an inventor who cannot be found or reached after diligent effort or who refuses to sign the oath or declaration.

In view of 35 U.S.C. 115(e), the Office will permit inventors to make the required statements in an assignment executed by the inventor and recorded in the Office. When the inventors choose to do so, the Office is proposing to require that the assignment cover sheet identify such an assignment as also being an oath or declaration.

35 U.S.C. 111(a)(2)(C) provides that the application “shall include an oath or declaration as prescribed by section 115 of this title.” Therefore, the Office is proposing to require that a copy of any recorded assignment submitted pursuant to 35 U.S.C. 115(e) as the inventor oath or declaration be filed in the application, rather than merely making reference to its recording in regard to the application.

Under 35 U.S.C. 115(f), the Office is permitted to delay requiring an oath or declaration until an application is in condition for allowance. The Office considered this option, but considers it better for the examination process and patent pendency to continue to require the oath or declaration during pre-examination.

The Office needs to know who the inventors are to prepare patent application publications and publish applications at eighteen months from their earliest filing date. The Office also needs to know who the inventors are to conduct examination (under

conditions of patentability in effect today as well as in effect under the Leahy-Smith America Invents Act). For instance, the Office must know the identity of the inventors to determine what prior art may be applied against the claimed invention or whether to issue a double patenting rejection. The inventorship in an application is not set until an oath or declaration is filed. See 37 CFR 1.41(a)(1) (the inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by 37 CFR 1.63, with certain exceptions).

In addition, delaying the requirement for an oath or declaration until allowance would also significantly add to overall patent pendency. The current practice for completing applications (i.e., obtaining any outstanding oath or declaration and filing fees) does not have a noticeable effect on patent pendency because it takes place during pre-examination when the application would otherwise be awaiting a first Office action by the examiner and applications are placed in the queue for examination by filing date order regardless of the date on which they are completed. No Technology Center (other than designs) had average first action pendency lower than twenty months to first action at the end of fiscal year 2011. See United States Patent and Trademark Office Performance and Accountability Report Fiscal Year 2011, at 162 (table 4) (2011). Thus, the current practice of completing applications during pre-examination avoids any noticeable impact on first action pendency and overall pendency. Stated differently, forwarding applications for examination without an oath or declaration would not change the first action pendency either under current first action pendency or when the Office reaches a ten-month first action.

Changing the practice of completing applications during pre-examination such that an oath or declaration is not required until an application is otherwise in condition for allowance would require the Office to issue some type of action (e.g., an action under Ex parte Quayle, 1935 Dec. Comm'r Pat. 11 (1935)) to obtain an oath or declaration before the Office is able to issue a notice of allowance under 35 U.S.C. 151. This would require an extra action during the examination process in any application in which an oath or declaration is not present before examination. About 33 percent of applications do not contain an oath or declaration on filing. In addition, based upon data for fiscal year 2011 in the Patent Application Location and Monitoring (PALM) database system, the average time taken for applicants to reply to an Ex parte Quayle action was 52 days, and the average time taken by examiners to respond to an applicant's reply to an Ex parte Quayle action was 32 days. Thus, a change in practice to permit an oath or declaration to be filed after the Office is ready to mail a notice of allowance could increase the total pendency for allowed applications by between one and three months (depending upon whether only 33 percent of applicants or all applicants delayed submission of an oath or declaration). This is also why identification of the inventor(s) in the application itself to be followed after the notice of allowance with the oath or declaration is insufficient.

The approach that will allow for an efficient publication and examination process while minimizing the impact on patent pendency is for an application to be completed prior to examination. Assignees should consider getting the oath or declaration and any assignment document executed concurrently or in the common declaration-assignment

document provided for in 35 U.S.C. 115(e) before filing an application. The Office also plans to streamline its practices to permit an assignee or an obligated assignee to readily execute an oath or declaration, or a person who otherwise shows sufficient proprietary interest to be able to readily execute an oath or declaration on behalf of an inventor, when such inventor is not able, willing, or available to execute the oath or declaration. Finally, for those few applicants who actually need more time than is permitted for completing applications during pre-examination, the Office has practices that would permit an extended period for completing an application (Pilot Program for Extended Time Period To Reply to a Notice To File Missing Parts of Nonprovisional Application, 75 FR 76401 (Dec. 8, 2010)), and will be proposing other ways to permit applicants to have additional time to complete an application for examination (see Track III of the Enhanced Examination Timing Control Initiative, 75 FR 31763 (June 4, 2010)).

The Office also considered discontinuing the practice of charging a surcharge for an application in which the oath or declaration is not present on filing. Applications that are not complete on filing (e.g., are filed without an oath or declaration, or without the filing fee) require special processing on the part of the Office. The Office appreciates that some applications need to be filed to avoid a loss of rights before all of the formal documents or fees are ready, but the Office thinks that the cost of the special processing required for such applications should be borne by those applicants who require special processing and not by applicants whose applications are complete on filing.

Consistent with 35 U.S.C. 115(g), the Office will permit applicants who executed an oath or declaration in a prior application, where appropriate, to use a copy of that oath or declaration in all continuing applications, including continuation-in-part applications, with the caveat that any added inventors in the continuing application must execute an original oath or declaration.

While the Office recognizes the ability of any person making a statement under 35 U.S.C. 115 to correct the statement at any time, including after issuance of the patent, as provided in 35 U.S.C. 115(h), the Office will not review the submission of such a document if it is not timely presented during prosecution of the application, except where there is a correction of inventorship in a patent made pursuant to 35 U.S.C. 256 and 37 CFR 1.324.

Consistent with the amendments made to 35 U.S.C. 115 and 251, the Office proposes changes to reissue practice to: (1) delete the requirement for a reissue oath or declaration to include a statement that all errors arose without any deceptive intent on the part of the applicant; (2) eliminate the requirement for a supplemental oath or declaration when a claim is amended, and require a corrected oath or declaration only where all errors previously identified in the reissue oath or declaration are no longer being relied upon as the basis for reissue; (3) require applicants to specifically identify any broadening of a patent claim, rather than merely provide an alternative statement that applicant is correcting an error of either claiming more or less than a patentee was entitled to claim; and (4) clarify that a single claim containing both a broadening and a narrowing of the

claimed invention is to be treated as a broadening. These changes will provide for more efficient processing of reissue applications and improve the quality of patents, in accordance with the intent of the Leahy-Smith America Invents Act. In order to implement the conforming amendment made to 35 U.S.C. 251 in Section 4(b)(2) of the Leahy-Smith America Invents Act, the Office is also proposing to amend the rules to permit an assignee of the entire interest who filed an application under 35 U.S.C. 118 that was patented to sign the reissue oath or declaration in a reissue application of such patent (even if the reissue application is a broadening reissue).

Where the Director grants a patent on an application filed under amended 35 U.S.C. 118 by a person other than the inventor, the Office must grant the patent to the real party in interest. Therefore, the Office proposes to require applicants other than the inventor to notify the Office of any change in ownership of the application no later than payment of the issue fee. Absent any such notification, the Office will presume no change in ownership of the application has occurred.

The Office, under the authority provided by 35 U.S.C. 2(b)(2), also proposes changes to the rules of practice for power of attorney, prosecution of an application by an assignee, and foreign priority claims to facilitate prosecution of applications and improve the quality of patents. Juristic entities who seek to take over prosecution of an application will need to do so via a registered practitioner. Juristic entity includes entities such as corporations or other non-human entities created by law and given certain legal rights. This practice is consistent with the general rule in Federal courts that a juristic entity

must be represented by counsel admitted to practice before the court. See, e.g., Osborn v. Bank of United States, 22 U.S. (9 Wheat.) 738, 830 (1824) (a corporation can appear in court only by attorney); Richdel, Inc. v. Sunspool Corp., 699 F.2d 1366 (Fed.Cir.1983) (corporation must be represented in court by an attorney); Southwest Express Co., Inc. v. Interstate Commerce Commission, 670 F.2d 53, (5th Cir. 1982) (a corporation or partnership must be represented in court by an attorney). The Office's experience is that the vast majority of juristic entities act via a registered practitioner, but a small number attempt to prosecute applications "pro se."

Other proposed changes include: providing for the carryover of a power of attorney in continuation and divisional applications, and in continuation-in-part applications where the inventorship is the same as in the immediate prior application; permitting practitioners who have acted only in a representative capacity in an application to change the correspondence address after a patent has issued; accepting the signature of a practitioner of record on a statement under 37 CFR 3.73(b) on behalf of an assignee without requiring further evidence of the practitioner's authority to act on behalf of the assignee; providing a procedure for handling conflicts between different purported assignees attempting to control prosecution; and harmonizing the practice regarding foreign priority claims with the practice regarding domestic benefit claims by requiring both types of claims to be set forth in an application data sheet.

Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Part 1, is proposed to be amended as follows:

Section 1.1: Section 1.1(e) is proposed to be amended to update the mail stop designation for communications relating to patent term extensions under 35 U.S.C. 156 to make it consistent with the Office's list of mail stops. Mail stops assist the Office in routing correspondence to the office or area assigned with treating it. Use of mail stops is not required but is strongly recommended, even where the documents are submitted via the Office's electronic filing system-Web (EFS-Web). A mail stop designation can help the Office more quickly identify the type of document where applicant did not select the correct document code when uploading a document through EFS-Web. For this reason, use of mail stops is encouraged.

Applicants are reminded that initial requests for patent term extension may not be submitted via EFS-Web and must be filed in paper. These initial requests are handled differently by Office personnel than other types of official patent correspondence. Therefore, the use of a mail stop will help ensure that initial requests are properly recognized and processed in a timely manner.

Section 1.4: Section 1.4(e) is proposed to be amended to require that a payment by credit card in patent cases may only be submitted with an original handwritten signature

personally signed in permanent dark ink or its equivalent. This change is proposed to avoid possible controversies regarding use of an S-signature (§ 1.4(d)(2)) instead of a handwritten signature (§ 1.4(d)(1)) for credit card payments, e.g., a request for refund where there is a change of purpose by the applicant and the request is based on use of an S-signature rather than a handwritten signature.

Section 1.31: Section 1.31 is proposed to be amended to create paragraphs (a) and (b).

Section 1.31(a) would retain the subject matter of the first sentence of current § 1.31 with the second sentence of current § 1.31 being placed in paragraph (b). Section 1.31(a) is proposed to be amended, under the authority provided by 35 U.S.C. 2(b)(2), to include a provision that a juristic entity must be represented by a patent practitioner. An additional clarification is provided that prosecution by a juristic entity is governed by § 3.71(a), and the taking of action by an assignee is governed by § 3.73. See also the discussion of § 1.33(f).

Section 1.32: Section 1.32(d) is proposed to be added to address the filing in a continuing application of powers of attorney from the parent application. Proposed § 1.32(d) provides that a power of attorney from a prior application for which benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in a continuing application may have effect in the continuing application if the inventorship of the continuing application is the same as the prior application or one or more inventors from the prior application have been deleted in the continuing application, and if a copy of the power of attorney from the

prior application is filed in the continuing application. Current § 1.63(d)(4) (proposed to be deleted in this notice) provides that, when filing continuation and divisional applications and including a copy of a declaration from the parent application, applicants should “identify” in the continuation or divisional any change in power of attorney that occurred after the filing of the parent application. The requirement in § 1.63(d)(4) to “identify” the change in power of attorney has been interpreted differently by applicants causing confusion for the Office as to who has the power of attorney. For example, some applicants have filed a copy of the power of attorney from the parent, while others have filed a copy of only the notice of acceptance of power of attorney or just made a statement about the power of attorney in a transmittal letter that accompanied the continuation or divisional application. Because of these past inconsistencies in “identifying” a change in power of attorney, specifically requiring a copy of the power of attorney from the prior application to be filed in the continuing application (even where a change in power did not occur in the prior application) will make the record clear with respect to who has power of attorney.

The Office does not recommend that practitioners use a combined declaration and power of attorney document and no longer provides a combined declaration and power of attorney form on its Internet Web site. The power of attorney should be from the assignee where one exists. Otherwise, the assignee may be paying the bill, while the inventor is providing the power of attorney, thereby possibly raising an issue as to who is the practitioner’s client. Additionally, relationships between an assignee and the inventors may deteriorate. It is not uncommon in these situations for inventors to stop

cooperating, and in some cases, file powers of attorney in an attempt to control prosecution of the application.

Section 1.32(e) is proposed to be added to clarify that, where a power of attorney has been granted by all of the inventors (as opposed to the assignee), the addition of an inventor pursuant to a request granted under § 1.48 results in the loss of that power of attorney unless the added inventor provides a power of attorney consistent with the existing power of attorney from the other inventors. This provision does not preclude a practitioner from acting pursuant to § 1.34, if applicable.

A power of attorney is a written document by which a principal (i.e., the applicant for patent or assignee of entire interest) authorizes one or more patent practitioners or joint inventors to act on his or her behalf. See § 1.32(a). Where a power of attorney from the inventors is already present in the application file, and a request is filed to add one or more inventors pursuant to § 1.48, the grant of the § 1.48 request results in the power of attorney of record being signed by less than all of the inventors. The Manual of Patent Examining Procedure specifies that papers giving a power of attorney in an application will not be accepted when signed by less than all of the inventors unless accompanied by a petition under § 1.183 and fee under § 1.17(f) demonstrating the extraordinary situation where justice requires the waiver of the requirement in § 1.32(b)(4) that all of the inventors sign the power of attorney. See Manual of Patent Examining Procedure (MPEP) § 402.10 (8th ed. 2001) (Rev. 8, July 2010). Because the inventive entity

changes upon grant of the § 1.48 request, the power of attorney of record can no longer be effective in the application.

It should be noted that a practitioner may only act in a representative capacity on behalf of all of the applicants or owners of a patent application, unless a petition is granted in accordance with MPEP § 402.10. Section 1.34 does not authorize a practitioner to take action in a patent application where he or she has authority or a power of attorney from less than all of the inventors or owners, and is not provided as a means to subvert the petition requirements set forth in MPEP § 402.10. Where a power of attorney was already of record in the file prior to the filing and grant of the § 1.48 request, and the practitioner cannot secure a power of attorney from each added inventor, the procedures set forth in MPEP § 402.10 must be followed, unless a power of attorney from the assignee of the entire right, title, and interest, or from partial assignees who collectively make up the entire right, title, and interest (after ownership is established pursuant to § 3.71) is filed.

Section 1.33: Section 1.33(a) is proposed to be amended to specify that if an applicant provides more than one correspondence address in a single paper or in multiple papers submitted on one day, the Office will select one of the specified addresses for use as the correspondence address and, if given, may select the correspondence address associated with a Customer Number over a typed correspondence address. This proposal addresses the problem that arises when applicants provide multiple correspondence addresses in a single paper (e.g., providing both a typed correspondence address and a Customer

Number in a single paper) or multiple papers (e.g., an oath or declaration, a transmittal letter, and a preliminary amendment that each includes a different correspondence address) on one day, and the Office inadvertently did not select the correspondence address actually desired by applicant. The Office may then need to re-mail papers to the desired address. This proposed change does not affect the hierarchy provided in § 1.76(d) for inconsistencies between an application data sheet and other documents. The proposed change is intended to encourage applicants to carefully review their submissions to ensure that the Office receives clear instructions regarding the correspondence address.

Section 1.33(b)(3) is proposed to be removed and reserved in view of changes proposed in § 1.33(f), which provides that a juristic entity may prosecute a patent application only through a patent practitioner. See the discussion of proposed § 1.33(f), below.

Section 1.33 is proposed to be amended to add a new § 1.33(f) to provide that an assignee may only conduct prosecution of an application in accordance with §§ 1.31 and 3.71. Thus, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner. This change is proposed because juristic entities have been attempting to prosecute patent applications before the Office pro se and consequently requesting additional assistance from the examiner. Juristic entities attempting to prosecute patent applications before the Office pro se also make more procedural errors that result in delays in prosecution. Accordingly, this proposal will facilitate a reduction in the Office backlog by reducing the delays.

Section 1.33 is proposed to be amended to add a new § 1.33(g) to replace § 1.63(d)(4) with respect to the correspondence address. Where application papers from a prior application are used in a continuing application and the correspondence address was changed during the prosecution of the prior application, an application data sheet or separate paper identifying the updated correspondence address to be used for the continuing application must be submitted. Otherwise, the Office may not recognize the change of correspondence address effected during the prosecution of the prior application. Where copies of submitted papers, e.g., an oath or declaration, contain an outdated address (that was changed during prosecution of the prior application), an application data sheet or separate paper identifying the updated correspondence address to be used must be submitted. Presently, some applicants file continuing applications with copies of papers from the prior application that include correspondence addresses to former law firms or that are no longer current. The proposal would facilitate the processing of patent applications by the Office by making it easier to determine the correct correspondence address and reduce the number of instances where the Office mails correspondence to an incorrect address.

Section 1.33 is proposed to be amended to add a new § 1.33(h) to provide that a practitioner acting in a representative capacity in an application may change the correspondence address after the patent has issued, provided that the change of correspondence address is accompanied by a statement that notice has been given to the applicant or owner. Proposed § 1.33(h) is intended to provide a means for practitioners

acting in a representative capacity in an application to effect a change in correspondence address after the patent has granted but would not provide authority to a practitioner acting under § 1.34 to change the correspondence address in an application after a § 1.63 oath or declaration by any of the inventors has been filed. See § 1.33(a)(2).

Practitioners that file and prosecute an application in a representative capacity, pursuant to § 1.34, usually provide their business address as the correspondence address of record. Once the patent issues, some practitioners attempt to withdraw as attorney or agent by filing a petition, and also attempt to change the correspondence address to direct correspondence to the applicant's or owner's address. Such attempts are not successful as the current rules do not permit the correspondence address to be changed by a practitioner acting in a representative capacity, nor will the Office grant withdrawal where a practitioner is not of record. See Change in Procedure for Requests to Withdraw from Representation In a Patent Application, 1329 Off. Gaz. Pat. Office 99 (Apr. 8, 2008). There have been instances where practitioners acting in a representative capacity have indicated that they have repeatedly requested that the client change the correspondence address, but the client has refused to submit the change of correspondence address to the Office. Proposed § 1.33(h) would permit practitioners to change the correspondence address after a patent has issued where practitioners have provided notice to the applicants or owners.

Section 1.41: Section 1.41(a)(3) is proposed to be amended to delete the language regarding provision of the citizenship of each person believed to be an inventor when the

application papers for a nonprovisional application are filed without an oath or declaration as prescribed by § 1.63, or when application papers for a provisional application are filed without a cover sheet as prescribed by § 1.51(c)(1). Thus, only the name and residence of each person believed to be an inventor should be provided when nonprovisional application papers are filed without an oath or declaration or provisional application papers are filed without a cover sheet.

Section 1.41(a)(4) is proposed to be amended to simplify correction of inventorship in a national stage application under 35 U.S.C. 371. Under the current provision of § 1.41(a)(4), to correct inventorship, applicants must either: (1) file an oath or declaration executed by the inventors identified in the international phase and then follow the procedures under § 1.48(b) or (c) to correct inventorship due to claim amendments; or (2) file a request to correct inventorship under § 1.497(d), where inventorship was erroneously identified in the international phase. The proposed amendment to § 1.41(a)(4) treats national stage applications as analogous to applications filed under 35 U.S.C. 111(a) in that the first submission of an executed oath or declaration acts to correct the earlier identification of inventorship. See current § 1.48(f)(1).

Section 1.41(c) is proposed to be amended to differentiate between the mere delivery of a patent application and other correspondence to the Office and the signing of official correspondence. Proposed § 1.41(c) would provide that any person may physically or electronically deliver an application for patent and related correspondence, including fees, to the Office on behalf of the inventor(s), except that an oath or declaration (§ 1.63)

can only be made in accordance with § 1.64. Proposed § 1.41(c) would also provide that amendments and other papers must be signed in accordance with § 1.33(b). This is consistent with the language of current § 1.33(b).

Section 1.42: Section 1.42 is proposed to be amended to set forth the procedures for satisfying the oath or declaration provisions of 35 U.S.C. 115 for deceased and legally incapacitated inventors in paragraphs (a) through (c). Current § 1.42 provides that in the case of the death of an inventor, the legal representative (e.g., executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Current § 1.43 provides that in the case of an inventor who is legally incapacitated, the legal representative (e.g., guardian, conservator, etc.) of the legally incapacitated inventor may make the necessary oath or declaration, and apply for and obtain the patent. 35 U.S.C. 115(d) sets forth the permitted circumstances in which the applicant for patent may provide a substitute statement in lieu of executing an oath or declaration under 35 U.S.C. 115(a). Specifically, the permitted circumstances in which a substitute statement may be made with respect to an individual include: (1) where the individual is deceased; (2) where the individual is legally incapacitated; (3) where the individual cannot be found or reached after diligent effort; or (4) where the individual is under an obligation to assign the invention but has refused to make the oath or declaration required under 35 U.S.C. 115(a). Proposed § 1.42 would cover the first two permitted circumstances, while proposed § 1.47 would cover the last two permitted circumstances. It is noted that 35 U.S.C. 115(d) also gives the Director the authority to specify additional circumstances by regulation.

Amended 35 U.S.C. 118 provides for a person to whom the inventor has assigned or is under an obligation to assign the invention to make an application for patent, and for a person who otherwise shows sufficient proprietary interest in the matter to make an application for patent on behalf of, and as agent for, the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties. Accordingly, the Office is proposing amendments to § 1.42 to provide for the ability of the assignee, a party to whom the inventor is under an obligation to assign the invention, or a party who otherwise shows sufficient proprietary interest to execute the oath or declaration under § 1.63 in the case of a deceased or legally incapacitated inventor, in addition to the legal representative of such an inventor. This oath or declaration, together with any necessary showing, constitutes the substitute statement provided for in 35 U.S.C. 115(d). The Office is interpreting the term “person” as used in 35 U.S.C. 118 as including juristic persons.

Proposed § 1.42(a) provides that in the case of the death or legal incapacity of the inventor, the legal representative (e.g., executor, administrator, guardian, or conservator) of the deceased or incapacitated inventor, the assignee, a party to whom the inventor is under an obligation to assign the invention or a party who otherwise shows sufficient proprietary interest in the matter may execute the oath or declaration under § 1.63.

Proposed § 1.42(a) further provides that the oath or declaration must comply with §§ 1.63(a) and (b) and identify the inventor who is deceased or legally incapacitated.

Proposed § 1.42(a) further provides that a party who shows sufficient proprietary interest

in the matter executes the oath or declaration on behalf of the deceased or incapacitated inventor.

Proposed § 1.42(b) provides that a party to whom the inventor is under an obligation to assign the invention or a party who otherwise has sufficient proprietary interest in the matter who is taking action under § 1.42 must file a petition, accompanied by the fee set forth in § 1.17(g) and a showing, including proof of pertinent facts, either that: (1) the deceased or incapacitated inventor is under an obligation to assign the invention to the party; or (2) the party has sufficient proprietary interest in the matter to execute the oath or declaration on behalf of the deceased or incapacitated inventor and that such action is necessary to preserve the rights of the parties. Legal representatives of deceased or incapacitated inventors would be able to execute the oath or declaration for such an inventor without the need for a petition, consistent with the practice under current §§ 1.42 and 1.43. In addition, assignees would now be able to execute the oath or declaration for a deceased or incapacitated inventor without the need for a petition. However, a party to whom the inventor is under an obligation to assign or a party who otherwise has sufficient proprietary interest would need to file a petition as set forth in proposed § 1.42(b) in order to execute the oath or declaration for a deceased or incapacitated inventor. The proof required would be similar to the current proof required when an assignee, a party to whom an inventor has agreed in writing to assign the invention, or a party who otherwise shows sufficient proprietary interest in the matter files a petition under current § 1.47(b). The proof required to show proprietary interest and to show that the action is necessary to preserve the rights of the parties in a petition under current

§ 1.47(b) is discussed in MPEP §§ 409.03(f) and (g). The language “or to prevent irreparable damage” contained in current § 1.47(b) has not been included in proposed § 1.42(b) because 35 U.S.C. 118, as amended by the Leahy-Smith America Invents Act, does not contain this language.

Proposed § 1.42(c) contains language similar to current § 1.42 (second sentence) with the addition of the term “assignee” and the limitation that the intervention must be “pursuant to this section.” Thus, where an inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative or the assignee upon proper intervention under § 1.42.

Section 1.43: Section 1.43 is proposed to be removed and reserved. The provisions relating to inventors who are legally incapacitated are proposed to be moved to § 1.42 and revised as discussed above.

Section 1.47: Section 1.47 is proposed to be amended to revise the procedures for when an inventor refuses to sign the oath or declaration or cannot be reached after diligent effort to sign the oath or declaration. Current § 1.47(a) provides a petition procedure for when an inventor refuses to sign the oath or declaration or cannot be reached after diligent effort, which requires each of the available inventors to sign the oath or declaration on behalf of himself or herself and the nonsigning inventor, a petition including proof of the pertinent facts, the petition fee in § 1.17(g), and the last known address of the nonsigning inventor. Current § 1.47(b) provides a petition procedure for

when all inventors are refusing to sign the oath or declaration or cannot be reached after diligent effort and thus no inventors are available to sign the oath or declaration. In this situation, current § 1.47(b) permits a person to whom the inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter, to sign the oath or declaration on behalf of and as agent for all the inventors. Current § 1.47(b) requires a petition including proof of pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the petition fee set forth in § 1.17(g), and the last known address of all inventors. Thus, under the current rule, the assignee, a party to whom the inventor has agreed in writing to assign the invention, or a party who otherwise shows sufficient proprietary interest in the matter can only sign the oath or declaration for a nonsigning inventor under § 1.47(b), when there are no inventors available to sign the oath or declaration.

Proposed § 1.47(a) provides that if an inventor or a legal representative of a deceased or incapacitated inventor refuses to execute the oath or declaration, or cannot after diligent effort be found or reached to execute the oath or declaration, then the assignee of the nonsigning inventor, a party to whom the inventor is obligated to assign the invention, or a party who otherwise shows sufficient proprietary interest may execute the oath or declaration. Proposed § 1.47(a) further provides that a party who shows sufficient interest in the matter executes the oath or declaration on behalf of the nonsigning inventor. This expands the situations in which an assignee, a party to whom the inventor is obligated to assign, or a party who otherwise shows sufficient proprietary interest can

execute the oath or declaration beyond what is permitted in current § 1.47(b). Thus, even if other inventors are signing the oath or declaration, the assignee of the nonsigning inventor, a party to whom the inventor is obligated to assign, or a party who otherwise shows sufficient proprietary interest would be able to execute the oath or declaration for the nonsigning inventor, accompanied by the petition under proposed § 1.47(a).

Proposed § 1.47(b) provides that if a joint inventor or legal representative of a deceased or incapacitated joint inventor refuses to execute the oath or declaration, or cannot be found or reached after diligent effort, the remaining inventor(s) may execute the oath or declaration on behalf of himself or herself and the nonsigning inventor. This is similar to the practice in current § 1.47(a) where the available inventor(s) can execute the oath or declaration on behalf of himself or herself and the nonsigning inventor. Current § 1.47(a) and (b) also apply to nonsigning legal representatives, although not expressly stated in the rule. Proposed § 1.47(a) and (b) make it explicit in the rule that the provisions apply to nonsigning legal representatives of deceased or incapacitated inventors.

Proposed § 1.47(c) provides that any oath or declaration executed pursuant to § 1.47 must comply with the requirements of § 1.63(a) and (b) and be accompanied by a petition that: (1) includes the petition fee set forth in § 1.17(g); (2) identifies the nonsigning inventor, and includes the last known address of the nonsigning inventor; and (3) states either that the inventor or legal representative cannot be reached after a diligent effort was made, or has refused to execute the oath or declaration when presented with a copy of the application papers, with proof of the pertinent facts. The proof required to show that the

inventor refuses to execute the oath or declaration, or cannot be found or reached after diligent effort, is the same level of proof currently required for § 1.47 petitions and is discussed in MPEP § 409.03(d).

In addition, proposed § 1.47(c)(4) requires a party to whom the nonsigning inventor is under an obligation to assign the invention, or a party who has sufficient proprietary interest in the matter acting under § 1.47(a) to also provide a showing, including proof of the pertinent facts, either that: (1) the nonsigning inventor is under an obligation to assign the invention to the party; or (2) the party has sufficient proprietary interest in the matter to execute the oath or declaration on behalf of the nonsigning inventor and that such action is necessary to preserve the rights of the parties. The proof required would be similar to the current proof required when an assignee, a party to whom an inventor has agreed in writing to assign the invention, or a party who otherwise shows sufficient proprietary interest in the matter files a petition under current § 1.47(b). As noted above in the discussion regarding proposed § 1.42, the proof required to show proprietary interest and to show that the action is necessary to preserve the rights of the parties is discussed in MPEP § 409.03(f) and (g). The language “or to prevent irreparable damage” contained in current § 1.47(b) has not been included in proposed § 1.47(c) because amended 35 U.S.C. 118 does not contain this language.

Proposed § 1.47(d) contains language similar to current § 1.47(c). Specifically, proposed § 1.47(d) provides that the Office will publish notice of the filing of the application in the Official Gazette, and the Office may send notice of the filing of the application to the

nonsigning inventors at the address(es) provided in the petition under § 1.47. The option to give notice via publication in the Official Gazette helps the Office to reach nonsigning inventors, particularly when the Office knows that such notice, if sent to the address(es) provided in the petition, would only be returned to the Office as being undeliverable. Proposed § 1.47(d) also permits the Office to dispense with the notice provision in a continuing application (including a continuation-in-part), not just a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor such as by publication in the Official Gazette.

Proposed § 1.47(e) provides that a nonsigning inventor or legal representative may subsequently join in the application by submitting an oath or declaration under § 1.63 subsequent to a § 1.47 petition being granted. This is similar to language contained in current § 1.47(a) and (b) that provides for a nonsigning inventor to subsequently join in the application by filing an executed oath or declaration complying with § 1.63.

Proposed § 1.47(e) also provides that the submission of an oath or declaration by a nonsigning inventor or legal representative after a § 1.47 petition has been granted will not permit the nonsigning inventor or legal representative to revoke or grant a power of attorney. This is not a change in practice but is merely a clarification of power of attorney practice.

Section 1.48: Section 1.48 is proposed to be amended to add paragraph (k) to provide for a simplified procedure for correcting inventorship in a national stage application. As discussed below, current § 1.497(d) and (e), which include provisions for correcting

inventorship in a national stage application, are proposed to be deleted. The corrective procedure in proposed § 1.48(k) has been simplified in light of the amendment to 35 U.S.C. 116 eliminating the requirement that the error in inventorship “arose without any deceptive intention” on the part of the inventor being added or the inventor being deleted. Proposed § 1.48(k) provides that the procedure in § 1.48(a) may also be used for correcting an error in inventorship in a national stage application under 35 U.S.C. 371 prior to becoming a nonprovisional application, and for correcting an error in the inventive entity set forth in an executed declaration submitted under PCT Rule 4.17(iv).

Section 1.48 is also proposed to be amended to eliminate the “without deceptive intention” requirement (as this requirement has been eliminated from 35 U.S.C. 116), and delete the reference to § 1.43 (as § 1.42 is proposed to be amended to include the subject matter of § 1.43).

Section 1.53: Section 1.53(f)(4) is proposed to be amended by revising reference to § 1.63(d) consistent with the proposed change in § 1.63(d). Specifically, the terms “continuation” and “divisional” in paragraph (f)(4) would be replaced by “continuing” to reflect that proposed § 1.63(d) also covers continuation-in-part applications.

Section 1.55: Sections 1.55(a)(1)(i), (c), and (d)(1)(ii) are proposed to be amended to require a foreign priority claim be identified in an application data sheet (§ 1.76), or a supplemental application data sheet, as is appropriate. The revision is intended to make clear what may be a confusing practice to practitioners. Currently, a foreign priority

claim may be located anywhere in an application for § 1.55 compliance, while compliance with current § 1.63(c) requires the foreign priority claim must be supplied in an application data sheet or identified in the oath or declaration. Thus, it is possible for an applicant's foreign priority claim to comply with § 1.55, but not § 1.63(c). The proposed amendment establishes a single location for the foreign priority claim in the application data sheet, which would facilitate application processing by providing practitioners with a clear location for the foreign priority claim, and the Office with one location to quickly locate the foreign priority claim.

35 U.S.C. 119(b) does not specify the particular location in the application for setting forth a claim to the benefit of a prior foreign application. However, 35 U.S.C. 119(b) provides that the foreign application is identified by specifying the application number, country or intellectual property authority, and filing date of each foreign application for which priority is claimed. In addition, 37 CFR 1.55(a)(1)(i) requires identification of any foreign application having a filing date before that of the application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for foreign priority as required by 35 U.S.C. 119(b) and § 1.55(a).

Providing this information in a single location will facilitate more efficient processing of applications, as the Office will only have to look at one location for the priority claim and the most recent application data sheet will govern. Currently, the Office must look at the specification, amendments to the specification, the oath or declaration, the application data sheet (if provided), and elsewhere to determine the priority claim. When applicants

provide inconsistent information relating to the claim for foreign priority, the Office must then determine which priority claim governs.

Additionally, providing this information in a single location will facilitate review of patents and patent application publications, because applications frequently provide a benefit and/or foreign priority claim in the first sentence(s) of the specification, which is superseded by an application data sheet that includes a different benefit or foreign priority claim, and thus the benefit claim and/or foreign priority information included in the first sentence(s) of the specification is different from the benefit claim and/or foreign priority information contained on the front page of the patent or patent application publication. While the benefit and/or foreign priority claim on the front page of the patent or patent application publication is usually correct, anyone (including an examiner, a practitioner, or the public) reviewing the patent or patent application publication must review the file history of the application to verify this to be correct.

Since most applications are filed with an application data sheet, requiring the benefit and/or foreign priority claims to be included in the application data sheet will not require most practitioners to change their practice.

Section 1.63: Section 1.63(a) is proposed to be amended to recite applicability of the paragraph to both 35 U.S.C. 111(a) national applications and 35 U.S.C. 371 national stage applications of international PCT applications. Section 1.63(a)(1) is proposed to be amended to delete the statement relating to a lack of a minimum age requirement as

unnecessary in view of the later requirement, proposed § 1.63(a)(6) (reformatted from current § 1.63(b)(2)), that the person signing has reviewed and understands the contents of the application.

Section 1.63(a)(2) is proposed to be amended to simplify the requirement for the inventor name to be his or her full name without reference to a family or given name, but an initial may only be provided for the middle name. The requirement for a full name is sufficient, given that individuals do not always have both a family name and a given name, or have varying understandings of what a “given” name requires.

Section 1.63(a)(3) is proposed to be amended to delete the requirement for identifying the country of citizenship for each inventor, as this information has been deleted as a requirement from 35 U.S.C. 115. Section 1.63(a)(3) would also be amended to set forth a requirement to identify the application to which the oath or declaration is directed (currently set forth in § 1.63(b)(1)).

Section 1.63(a)(4) is proposed to be amended to delete the requirement that the person executing the oath or declaration state that he or she is believed to be the “first” inventor consistent with the language in 35 U.S.C 115(b)(2) and with the statutory change to a first-inventor-to-file system from a first-to-invent system. Additionally, § 1.63(a)(4) is proposed to be clarified by adding the term “joint” before inventors and referring to the submission of the oath or declaration rather than referring to a patent being sought.

Section 1.63(a)(5) is proposed to be added to contain the requirement from 35 U.S.C. 115(b)(1) that the oath or declaration state that the application was made or was authorized to be made by the inventor.

Section 1.63(a)(6) is proposed to be added to contain the requirement from current § 1.63(b)(2) that the person making the oath or declaration has reviewed and understands the application. Sections 1.63(a)(4) and (a)(6), as proposed, also require that the averments therein be applicable in any application for which the oath or declaration is being submitted such as a continuing application.

Section 1.63(a)(7) is proposed to be added to contain the requirement from current § 1.63(b)(3) regarding the § 1.56 duty being acknowledged.

Section 1.63(b) is proposed to be amended by reciting the requirements for the mailing address and the residence of an inventor (transferred from current § 1.63(c)(1)), and adds the alternative of using an application data sheet (transferred from current § 1.63(c)). The mailing address requirement would be further clarified by noting that it is the address where the inventor “customarily receives mail,” which may encompass an address where the inventor works, a post office box, or other address where mail is received, even if it is not the main mailing address of the inventor. The mailing address is for the benefit of the inventor in the event that the Office needs to contact the inventor directly. Accordingly, care should be taken in identifying the mailing address, but the requirement is not one that the Office would investigate or confirm its accuracy. Current §§ 1.63(b)(1) through

(b)(3) are proposed to be deleted as the requirements are moved to other portions of proposed § 1.63 (i.e., current paragraph (b)(1) is moved to paragraph (a)(3), current paragraph (b)(2) is moved to paragraph (a)(6), and current paragraph (b)(3) is moved to paragraph (a)(7)).

Section 1.63(c) and (c)(1) are proposed to be amended by moving the current requirements to paragraph (b). Current § 1.63(c)(2) is proposed to be amended by deleting the current requirement for identifying the claim for foreign priority under § 1.55 in the oath or declaration. This amendment reflects the Office's desire to harmonize presentation of a claim for foreign priority under § 1.55 and of a claim for domestic benefit under § 1.78. The current requirement that the domestic claim for benefit be placed in the first sentence(s) of the specification or an application data sheet (§ 1.76), while requiring that a foreign priority claim be identified in an oath or declaration or application data sheet has led to confusion by applicants as to the proper placement of these priority or benefit claims and to Office processing issues of such claims. As Section 3 of the Leahy-Smith America Invents Act has placed foreign priority claims on equal footing as domestic benefit claims regarding what may be relied upon as a prior art date, it is important that there be one unified place that the Office and the public can rely upon in determining the presence of these claims. Accordingly, §§ 1.55 and 1.78 are proposed to be amended to provide for a unified way in the application data sheet to present foreign priority and domestic benefit claims for inclusion in a printed patent or a patent application publication.

Sections 1.63(c)(1)(i) and (ii) are proposed to provide for the use of assignments to also include the oath or declaration as provided in 35 U.S.C. 115(e). Proposed §§ 1.63(c)(1)(i) and (ii) would provide that the inventor can, when executing an assignment of his or her invention, include the information and statements that would be required under §§ 1.63(a) and (b). Section 1.63(c)(1)(ii) would require that the assignment be made of record by recording the assignment, and filing the copy of the assignment in the application for which it is being used as an oath or declaration. If the assignment has not been recorded prior to its reliance in an application, the assignment may be sent for recording at the same time it is being submitted in the application, provided applicant makes a statement to that effect. Applicants need to be mindful of the proposed amendment in § 3.31 requiring a conspicuous indication, such as by use of a check-box on the assignment cover sheet, to alert the Office that an assignment submitted with an application is submitted for a dual purpose: recording in the assignment database, such as to support a power of attorney, and for use in the application as the oath or declaration. Assignments cannot be recorded unless an application number is provided against which the assignment is to be recorded.

Currently, when an assignment is submitted for recording along with a paper application, the assignment is separated from the paper application and forwarded to the Assignment Recordation Branch for recording in its database at the time when the application is assigned an application number. The assignment in such case does not become part of the application file.

Under the proposed new permitted use of an assignment as including an oath or declaration, the Office, when it receives an assignment with a paper application filing, will continue to forward the assignment to the Assignment Recordation Branch without making it part of the application file, unless the check-box is used on the assignment cover sheet to indicate the intended use of the assignment to comply with the oath or declaration requirement. Where the check-box is used, the Office will make a copy of the assignment to scan the assignment into the Image File Wrapper (IFW) file for the application before forwarding it to the Assignment Recordation Branch. Failure to utilize the check-box will result in a Notice to File Missing Parts of Nonprovisional Application for an oath or declaration, as the assignment will not be made part of the application file and the Office will not recognize compliance with the § 1.63 oath or declaration requirement. A copy of the assignment would need to be submitted in reply to the Notice along with the surcharge for the late submission of the oath or declaration.

The Office has considered not requiring use of a check-box and automatically scanning an assignment into the IFW file for the application, but the Office believes that applicants should be provided with the option of submitting an assignment only for recordation purposes without such assignment becoming part of the IFW file.

For EFS-Web filing of application papers, EFS-Web does not accept assignments for recording purposes when filing an application. See Legal Framework for Electronic Filing System – Web (EFS-Web), 74 FR 55200, 55202 (Oct. 27, 2009). Recording of assignments may only be done electronically in EPAS (Electronic Patent Assignment

System), notwithstanding the existence of a link from EFS-Web to EPAS that can be utilized to file an assignment after the application is filed. Accordingly, for EFS-Web submissions, all assignments submitted on filing of the application or later submitted will be made of record in the application (entered into the Image File Wrapper (IFW)), and will not be forwarded to the Assignment Recordation Branch for recordation by the Office. Thus, an assignment must be separately submitted to the Assignment Recordation Branch, and in the application file where the assignment is to be used for a dual purpose. It is the intention of the Office to develop a system whereby one submission of an assignment can be electronically treated for the dual purpose.

The Office considered whether a clarifying amendment to § 1.12(b) should be made to state that a recorded assignment should be available to the public where it is used as the oath or declaration. However, assignment records are available to the public whenever the related application is available to the public. As proposed, a copy of the recorded assignment document would become part of the application file and would be available to the public when the application becomes available to the public.

Section 1.63(c)(2) is proposed to provide that any reference to an oath or declaration pursuant to § 1.63 would include the assignment as provided for in § 1.63.

Section 1.63(d)(1) is proposed to be amended to provide that a newly executed oath or declaration in an application claiming benefit under 35 U.S.C. 120, 121, or 365(c) is not required in a later-filed application where the oath or declaration in the earlier-filed

application is compliant with § 1.78. Section 1.63(d)(1) is also proposed to be amended to add a reference to § 1.497(a).

The Office considered whether to restrict the use of a copy of an oath or declaration to one from an “immediate” earlier-filed application, but determined that an oath or declaration copy could be used from any earlier-filed application in a chain of benefit claims so long as the oath or declaration continues to be appropriate. This interpretation reflects the breadth of the language utilized by the statute.

35 U.S.C. 115(g)(1)(A) provides an exception to the requirement for an oath or declaration for applications where the application claims the benefit under 35 U.S.C. 120, 121, or 365(c) of the filing of an earlier-filed application. As a claim for benefit under 35 U.S.C. 120 includes continuation-in-part (CIP) applications, it is also proposed to extend the use of copies of oaths or declarations to CIP applications where appropriate, in addition to the current continuations and divisional applications, by the use of the term “continuing.” Applicants are advised that it would not be proper to submit any paper, e.g., a copy of a declaration, in a continuing application that contains misstatements relative to the continuing application. Sections 1.63(a)(4) and (a)(6) are proposed to require that their statements (that the person executing the oath or declaration believes the named inventor or joint inventors to be the original inventor or original joint inventors of the claimed invention in the application, and that the person making the oath or declaration has reviewed and understands the contents of the application) be applicable to the “application for which the oath or declaration is being submitted,” which includes any

continuing application for which a copy of an oath or declaration is being submitted under 35 U.S.C. 115(g) and § 1.63(d). Thus, the following statements in the oath or declaration must be true for the continuing application in order for an oath or declaration from a prior application to be properly submitted in the continuing application under 35 U.S.C. 115(g) and § 1.63(d): (1) that the person executing the oath or declaration believes the named inventor or joint inventors to be the original inventor or original joint inventors of the claimed invention in the application for which the oath or declaration is being submitted (i.e., the oath or declaration states the correct inventorship for the continuing application); (2) that the person making the oath or declaration has reviewed and understands the contents of the application for which the oath or declaration is being submitted, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and (3) that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

Section 1.63(d)(1)(i) is proposed to be simplified by eliminating the word “nonprovisional” as unnecessary since provisional applications do not require an oath or declaration, and by referring to compliance with the section as opposed to individual paragraphs of the section. Section 1.63(d)(1)(ii) is proposed to contain the requirement set forth in current § 1.63(d)(1)(iv) relating to the oath or declaration copy showing the signature or an indication thereon that it was signed. The requirement of current § 1.63(d)(1)(ii), relating to deleting inventors, is proposed to be moved to proposed § 1.63(d)(2). The requirement of current § 1.63(d)(1)(iii) is proposed to be deleted in

view of the applicability of proposed § 1.63(d) to continuing applications, including continuation-in-part applications. Current § 1.63(d)(1)(iv) subject matter, relating to the presence of a signature, is proposed to be moved to proposed § 1.63(d)(1)(ii). Section 1.63(d)(1)(iii) is proposed to require that any new inventors named in the continuing application provide an executed oath or declaration in compliance with this section.

Section 1.63(d)(2) is proposed to contain the requirements set forth in current §§ 1.63(d)(1)(ii) and 1.63(d)(2) relating to the continuing application seeking to name fewer inventors and a statement requesting deletion of the name or names of the person who are not inventors. It is also proposed to require that such a statement requesting deletion be signed pursuant to § 1.33(b). Additionally, proposed § 1.63(d)(2) applies to continuing applications to include continuation-in-part applications, rather than just continuation and divisional applications.

Section 1.63(d)(3) is proposed to contain the requirements of current § 1.63(d)(3), (d)(3)(i), and (d)(3)(ii) in simplified form. The provision for submission of a copy of an oath or declaration where the earlier-filed application has been accorded status under § 1.47 has been expanded to cover § 1.42 situations relating to a deceased or legally incapacitated inventor.

Current § 1.63(d)(4) is proposed to be deleted. The power of attorney in a continuing application would be covered in proposed § 1.32. The correspondence address in a continuing application would be treated in proposed § 1.33(g).

Section 1.63(d)(5) is proposed to be deleted. Whether a newly executed declaration by an added inventor is required in a continuing application would be covered by § 1.63(d)(1).

Section 1.63(e) is proposed to be revised in that the current requirement for a newly executed declaration in (CIP) applications would be covered by § 1.63(d)(1). It is proposed that § 1.63(e) be amended to cover the submission of oaths or declarations pursuant to 35 U.S.C. 115(h)(1). 35 U.S.C. 115(h)(1) provides that any person making a statement under this section may at any time “withdraw, replace, or otherwise correct the statement at any time.” Section 1.63(e) as proposed would acknowledge that an oath or declaration submitted at any time pursuant to 35 U.S.C. 115(h)(1) would be placed in the file record of the application or patent, but may not be reviewed by the Office in view of the open ended time frame that the statute provides. Oaths or declarations submitted pursuant to 35 U.S.C. 115(h)(1) that are timely submitted during prosecution of an application would continue to be reviewed for compliance. A reminder is set forth that mere submission of an oath or declaration pursuant to 35 U.S.C. 115(h)(1) would not, however, act to correct inventorship as compliance with § 1.48 in an application and § 1.324 in a patent is required.

Section 1.64: Section 1.64(b) is proposed to be amended to eliminate the requirement that the oath or declaration must state the citizenship of the legal representative who is signing the oath or declaration for a deceased inventor. Since the requirement for an

inventor to state his country of citizenship in the oath or declaration has been eliminated from 35 U.S.C. 115, there is no basis to require the legal representative of an inventor to state the legal representative's citizenship. Section 1.64(b) is also proposed to be amended to change the phrase "deceased inventor" to "deceased or legally incapacitated inventor" in the second sentence. This change would require both a legal representative of a deceased inventor and a legal representative of an incapacitated inventor to state that the person is a legal representative. Additionally, the residence and mailing address of the legal representative would also be required, but § 1.64 is proposed to be amended to permit such information to be provided in an application data sheet. This will permit the submission of such information without requiring additional contact with the legal representative of a deceased or legally incapacitated inventor. Section 1.64(b) is also proposed to be amended to delete the reference to § 1.43 since § 1.43 is proposed for combination with § 1.42.

Section 1.67: The title of § 1.67 is proposed to be amended to "Noncompliant oath or declaration" to better focus on the purpose of the rule. 35 U.S.C. 115(h) limits the situations in which the Office may require a supplemental oath or declaration. Section 1.67 is amended to address the manner in which deficiencies in an oath or declaration can be corrected.

Section 1.67(a) is proposed to be amended to refocus the language therein away from a supplemental oath or declaration to an oath or declaration that complies with the requirements of 35 U.S.C. 115 and § 1.63 or 1.162. Sections 1.67(a)(1) and (2) are

proposed to be amended to conform to the changes to the title and § 1.67(a) by replacing the term “supplemental” with “ in compliance,” and to delete reference to § 1.43 as § 1.43 is being proposed to be combined with § 1.42. Section 1.67(a)(3) is proposed to be amended by deleting the explanatory parenthesis as unnecessary in view of the cross-reference to § 1.63 and updating the reference to recite § 1.63(b). Additionally, it is proposed to refer to a supplemental application data sheet in place of application data sheet, as a § 1.76 submission submitted after filing of the application must be a supplemental application data sheet and not an application data sheet even though it is the first § 1.76 submission.

Section 1.67(b) is proposed to retain the material from current § 1.67(b) relating to no new matter by deleting the term “supplemental,” as revised § 1.67 is clarified to be directed towards noncompliant oaths or declarations correcting deficiencies or inaccuracies.

Section 1.76: Section 1.76(a) is proposed to be amended to clarify that an application data sheet may be submitted in an international application entering the national stage under 35 U.S.C. 371. Section 1.76(a) is also proposed to be amended to require that an application data sheet must be submitted to claim priority to or the benefit of a prior-filed application under 35 U.S.C. 119, 120, 121, or 365 for consistency with the proposed changes to §§ 1.55 and 1.78.

Section 1.76(c)(1) is proposed to be amended to clarify that after an application has been filed, a supplemental application data sheet, not an application data sheet, is required.

Section 1.76(c)(2) is proposed to be amended to require that changes to the information must be indicated by underlining for insertions of text, and strike-through or brackets for deletions of text.

The revision is intended to make clear the difference between an application data sheet and a supplemental application data sheet. When an application data sheet is provided, the application data sheet becomes part of the application as filed and thus it does not have to be signed by the applicant, unless it is a form such as PTO/SB/14 and a nonpublication request is being made by the applicant on the form. When a supplemental application data sheet is provided, the supplemental application data sheet is an amendment to the application, and therefore the supplemental application data sheet must be signed in accordance with § 1.33(b). Applicants are also encouraged and reminded to use and submit an application data sheet (PTO/SB/14) as an EFS-Web Fillable Form, rather than a scanned PDF image, to benefit from having the data loaded directly into USPTO electronic systems (there is no Office form for a supplemental application data sheet). Use of an application data sheet benefits both the Office and patent practitioners as the data is loaded directly into the USPTO electronic systems, thus the data is accurately captured, reducing time that is needed to review the Filing Receipt.

Representative information including the registration number of each practitioner, or the customer number, appointed with a power of attorney or authorization of agent in the

application may be provided on an application data sheet. Providing this information in the application data sheet does not constitute a power of attorney or authorization of agent in the application (see §§ 1.76(b)(4), 1.34).

Section 1.76(d) continues to set forth the procedure for resolving inconsistencies between application data sheets and other documents. The Office contemplated clarifying this subsection to address the situation where inconsistent information regarding a benefit claim and/or foreign priority is supplied by the application data sheet and the specification as filed, and provide that the application data sheet will govern. In view of the proposed changes to §§ 1.55 and 1.78, which state that benefit and/or foreign priority claims must be in an application data sheet, there is no need for this further clarification.

Section 1.76(d)(1) is proposed to be amended to exclude foreign priority claims in accordance with § 1.55(a)(1) and benefit claims in accordance with §§ 1.78(a)(2)(iii) and 1.78(a)(5)(iii) from this subsection of the rule, which indicates which information will govern when inconsistent information is provided in an application. With the amendments to §§ 1.55(a)(1), 1.78(a)(2)(iii), and 1.78(a)(5)(iii), the foreign priority claim and/or benefit claim must be in the application data sheet. Thus, an amendment to the specification will not govern over a foreign priority claim or benefit claim in an application data sheet.

Section 1.78: Section 1.78(a)(2)(iii) is proposed to be amended such that the reference requirement for a benefit claim to a prior-filed nonprovisional application or international

application designating the United States of America by a later-filed nonprovisional application must be in an application data sheet or a supplemental application data sheet.

Sections 1.78(a)(5)(iii) is proposed to be amended such that the reference requirement for a benefit claim to a prior-filed provisional application by a later-filed nonprovisional application must be in an application data sheet or a supplemental application data sheet.

Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120. The patent statute requires that a claim to the benefit of a provisional (35 U.S.C. 119(e)(1)) or nonprovisional (35 U.S.C. 120) be in the application by specific reference thereto. Since the application data sheet (if provided) is considered part of the application, the specific reference to an earlier filed provisional or nonprovisional application in the application data sheet meets the “specific reference” requirement of 35 U.S.C. 119(e)(1) or 120.

Providing this information in a single location will facilitate more efficient processing of applications, as the Office will only have to look at one location for the benefit claim and the most recent application data sheet will govern. Currently, the Office must look at the specification, amendments to the specification, and the application data sheet if provided to determine the benefit claim. When applicants provide inconsistent information between the three sources, the Office must then determine which benefit claim governs in accordance with the rule.

Providing this information in a single location will also facilitate review of patents and patent application publications, because applications frequently provide a benefit and/or foreign priority claim in the first sentence(s) of the specification, which is amended by an application data sheet that includes a different benefit or foreign priority claim, and thus the benefit claim and/or foreign priority information included in the first sentence(s) of the specification is different from the benefit claim and/or foreign priority information contained on the front page of the patent or patent application publication. While the benefit and/or foreign priority claim on the front page of the patent or patent application publication is usually correct, anyone (including an examiner, a practitioner, or the public) reviewing the patent or patent application publication must review the file history of the application to verify this to be correct.

Since most applications are filed with an application data sheet, requiring benefit and/or foreign priority claims to be included in the application data sheet will not require most practitioners to change their practice.

Section 1.172: Section 1.172 is proposed to be amended in its title to delete the duplicative reference to assignees, as assignees may be an applicant in some circumstances for a reissue application. Section 1.172 is proposed to be reformatted to clarify who may sign, and what documents must accompany, a reissue oath or declaration. Section 1.172(a) is proposed to be amended to continue to require that the reissue oath or declaration must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent. Current subject matter in § 1.172(a)

relating to not enlarging the scope of the claims would be transferred to paragraph (b) and the assignment information transferred to paragraph (c). Section 1.172(b) is proposed to be amended to focus on signing of the oath or declaration and includes paragraph titles to distinguish between who may sign the reissue oath or declaration for a nonbroadening reissue (proposed § 1.172(b)(1)(i) through (b)(1)(iii)) versus a broadening reissue (§ 1.172(b)(2)(i) and (b)(2)(ii)). Current subject matter in § 1.172(b) would be moved to proposed § 1.172(d). Section 1.172(b)(2)(ii) is proposed to authorize the assignee of the entire interest to sign the reissue oath or declaration for a broadening reissue filed on or after September 16, 2012, where the application for the original patent was filed by the assignee of the entire interest (i.e., the oath or declaration was executed by the assignee under § 1.42 or § 1.47).

Section 1.172(c) includes the language already present in current § 1.172(a) and clarifies that all assignees, including partial assignees, who consent to the reissue must establish their ownership in the patent. Section 1.172(d) repeats the language found in current § 1.172(b).

Section 1.175: Section 1.175(a) is proposed to be amended to clarify the requirement that an applicant identify in the reissue oath or declaration each applicable reason that forms the basis for reissue. The reasons include: (1) a defective specification or drawing (§ 1.175(a)(1)); (2) the patentee claiming more than the patentee had a right to claim in the patent (§ 1.175(a)(2)); and (3) the patentee claiming less than the patentee had the right to claim in the patent (§ 1.175(a)(3)). Proposed § 1.175(a)(3) also requires

identification of a broadened claim and a broadened portion of the specification, if a change thereto is the basis for the claim broadening.

Section 1.175(a) retains the requirement from current § 1.175(a)(1) that the reissue oath or declaration identify at least one error that is being relied upon as the basis for reissue and recites the statutory basis for reissue, 35 U.S.C. 251. Examples of proper error statements are discussed in MPEP § 1414, II. The reissue oath or declaration may identify more than one specific error that forms the basis of the reissue, but at least one error must be identified.

Section 1.175(b) is proposed to be amended to clarify that a claim broadened in any respect must be treated and identified as a broadened claim. In addition, § 1.175(b) is proposed to be further amended to delete the requirement for supplemental reissue oaths or declarations in view of the change to 35 U.S.C. 251 in Section 20 of the Leahy-Smith America Invents Act (i.e., removal of the “without any deceptive intention” provision). A claim that is broadened in any respect is a broadened claim for purposes of 35 U.S.C. 251. See Tillotson, Ltd. v. Walbro Corp., 831 F.2d 1033, 1037 n.2 (Fed. Cir. 1987), In re Ruth, 278 F.2d 729, 730 (CCPA 1960), and In re Rogoff, 261 F.2d 601, 603 (CCPA 1958). The requirement that a claim broadened in any respect be treated as a broadened claim is important to distinguish who can sign the reissue oath or declaration. It also is important because a reissue application that broadens the scope of the original patent may only be filed within two years from the grant of the original patent. See MPEP § 1412.03 for the meaning of a “broadened reissue claim” and examples.

An application that does not seek to broaden the scope of the original patent may be filed with a reissue oath or declaration that is executed by the assignee of the entire right, title, and interest. However, if the reissue application broadens one or more of the claims in any respect, the reissue oath or declaration must be executed by the inventors, the legal representatives of deceased or legally incapacitated inventors, or a § 1.47 applicant for a nonsigning inventor (proposed § 1.172(b)(2)(i)). As discussed above, the assignee of the entire interest may sign the reissue oath or declaration for a broadening reissue filed on or after September 16, 2012, where the application for the original patent was filed by the assignee of the entire interest (proposed § 1.172(b)(2)(ii)), that is, the oath or declaration was executed by the assignee under §§ 1.42 or 1.47.

Section 1.175(c) is proposed to be amended to clarify that where all errors identified in the reissue oath or declaration pursuant to proposed § 1.175(a) are no longer being relied upon as the basis for reissue, a reissue oath or declaration that identifies a new error currently being relied upon as the basis for reissue must be filed. The elimination of supplemental reissue oaths or declarations in current § 1.175(b) is directed towards lack of deceptive intent regarding the error being corrected, and not the statutory requirement of identification of at least one error. Section 1.175(c) is also proposed to be amended to clarify that the reissue oath or declaration that identifies the new error currently being relied upon as the basis for reissue need only address the new error and need not identify any prior error identified in a reissue oath or declaration. This requirement is consistent with the discussion in MPEP § 1414.01, I.

The reissue oath or declaration must identify a proper error that forms the basis for reissue. If the specified error is no longer being corrected in the reissue application, then a new error must be identified in the reissue oath or declaration so that the record is clear in identifying a proper basis for reissue. The latest reissue oath or declaration need not identify each specific error that was identified in any earlier reissue oath or declaration; it must only identify an error that is currently being relied upon or corrected.

Section 1.175(e) is proposed to be amended to provide a title to identify the paragraph's applicability to continuing applications, MPEP 1414, II, and to clarify in the rule the ability to file copies of reissue oaths or declarations from prior reissue applications in continuing applications consistent with § 1.63(d). Section 1.175(e) would now consist of paragraphs (e)(1), (e)(2), (e)(2)(i) and (ii).

Section 1.175(e)(1) is proposed to provide that where a continuing reissue application replaces a prior reissue application, the requirement for a reissue oath or declaration pursuant to § 1.172 may be satisfied by a copy of the reissue oath or declaration from the prior reissue application it replaces. The concept of a "prior application," in this paragraph and in paragraph (e)(2), is intended to be broader than an immediate prior application but to stay within the bounds of § 1.63(d) and require a prior application that is within the chain of benefit claim.

Section 1.175(e)(2) is proposed to provide that where a continuing reissue application does not replace a prior reissue application, the requirement for a reissue oath or declaration pursuant to § 1.172 may be satisfied by a newly executed oath or declaration that identifies at least one error in the original patent which has not been corrected in a prior reissue application, § 1.175(e)(2)(i), or how an identified error is currently being corrected in a manner different than in a prior reissue application, § 1.175(e)(2)(ii).

Under current practice, a new oath or declaration is required in a continuing reissue application notwithstanding that there is no change in the error being corrected. In certain circumstances, such as set forth in the following examples, applicants request that they be allowed to use a copy of the declaration from prior reissue application. Some situations currently need to be addressed via a petition for waiver under § 1.183 with a \$400 fee, that the Office would grant in appropriate circumstances, such as set forth in the following example 2. The rule as now proposed recognizes the unnecessary processing delay and expense engendered by this practice, which would be rectified by this proposed change.

Accordingly, a copy of a reissue oath or declaration from a prior reissue application may be submitted in a continuing reissue application where the continuing application replaces a prior reissue application.

Also, a copy of a reissue oath or declaration from a prior reissue application may be submitted in a continuing application where the continuing application does not replace a

prior application, but only where the identified error was not corrected and therefore would continue to apply in the continuing reissue application, or where the identified error is currently to be corrected in the continuing application in a manner different than in the prior application. However, to do so would also require a statement to either effect. Otherwise, a reissue oath or declaration that identifies a new error that is the basis for reissue must be filed. The following are examples where a copy may be used:

Example 1: A reissue application is filed with a declaration under § 1.175 that lists more than one error that properly supports reissue. The declaration can be used to file a continuing reissue application, even if applicant is no longer attempting to correct some of the originally listed errors, provided that at least one of the originally listed errors remains that was not corrected in the prior application. Under the current and proposed § 1.175, a copy may be used.

Example 2: A reissue application is filed to amend Claim 4 to limit the general pump means to a centrifugal pump, and to eliminate the recitation of a refrigeration means. The reissue oath or declaration must state that the applicant believes the original patent to be wholly or partly inoperative or invalid by reason of patentee claiming more than the patentee had the right to claim in the patent (§ 1.175(a)(2)), and patentee claiming less than patentee had the right to claim, and identify Claim 4 (§ 1.175(a)(3)). An identification that the defect was that the patentee claimed “more or less” than patentee had a right to claim would not comply with proposed § 1.175. Moreover, the identification that Claim 4 is being broadened under proposed § 1.175(a)(3) would not be

sufficient to specifically identify at least one error under proposed § 1.175(a). Applicant must clearly specify the defect or error in the language that renders the original patent wholly or partly inoperative or invalid. The reissue oath or declaration must also provide a specific identification of one of the errors, e.g., Claim 4 was unduly limited by the inclusion of “refrigeration means” and is being amended to eliminate this recitation. Under the current rule, a petition under § 1.183 is required for a copy to be used. Under proposed § 1.175, a petition is not required for a copy to be used.

The reference in current § 1.175(e) to paragraph (a)(1) of § 1.175 would be deleted as it would be unnecessary in view of the proposed changes.

Section 1.175(f) is proposed to be added to provide that a reissue oath or declaration may be filed at any time pursuant to 35 U.S.C. 115(h)(1), and will be placed in the file record of the reissue application but may not be reviewed by the Office in view of the open ended time frame that the statute provides. Oaths or declarations submitted pursuant to 35 U.S.C. 115(h)(1) that are timely submitted during prosecution of an application would continue to be reviewed for compliance. Proposed § 1.175(f) is consistent with the language of proposed § 1.63(e).

Section 1.311: Section 1.311 is proposed to be amended by adding a new paragraph (c) to implement the requirement of 35 U.S.C. 118 that “[i]f the Director grants a patent on an application filed under [35 U.S.C. 118] by a person other than the inventor, the patent shall be granted to the real party in interest and upon such notice to the inventor as the

Director considers to be sufficient.” Proposed § 1.311(c) provides that where an assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter has filed an application under §§ 1.42, or 1.47, the applicant must notify the Office of any change in ownership of the application no later than payment of the issue fee. The Office will treat the absence of such a notice as an indication that there has been no change in ownership of the application. Proposed § 1.311(c) does not cover assignees or persons who otherwise show sufficient proprietary interest, unless the application is filed pursuant to §§ 1.42 or 1.47.

Section 3.81 currently provides that an “application may issue in the name of the assignee” “where a request for such issuance is submitted with payment of the issue fee.” This is accomplished by providing the assignee information in box 3 of the issue fee transmittal form, form 85B. The use of box 3 would be required where ownership of the application changed from the filing of the application and the application was filed pursuant to §§ 1.42 or 1.47.

Section 1.497: Section 1.497 is proposed to be amended to be consistent with the amendments to 35 U.S.C. 115 and the proposed amendments to § 1.63. Under the current provisions of § 1.497, while an oath or declaration in a national stage application under 35 U.S.C. 371 must comply with the requirements of § 1.63, it will be accepted as sufficient for purposes of entering the U.S. national stage if certain minimum requirements are met. See § 1.497(c). The proposed amendment to § 1.497(a) through

(c) maintains this practice. The reference to § 1.43 in current § 1.497(b)(1) and (2) would be deleted from the subject matter now found in the proposed § 1.497(b)(6).

Current § 1.497(d) through (e) are proposed to be deleted. A simplified procedure for correcting inventorship in a national stage application is proposed to be added to § 1.48, as new subsection § 1.48(k), since § 1.48 covers correction of inventorship in patent applications (other than reissue). The corrective procedure has been simplified in light of the amendment to 35 U.S.C. 116 eliminating the requirement that the error in inventorship “arose without any deceptive intent” on the part of the inventor being removed or added. Current § 1.497(f) is proposed to be deleted because of the amendment to 35 U.S.C. 115. Current § 1.497(g) is proposed to be deleted in view of the proposed amendment to § 1.63 eliminating foreign priority claims from the oath or declaration.

Section 3.31: Section 3.31 is proposed to be amended by the addition of new paragraph (h) that would implement 35 U.S.C. 115(e) permitting use of an assignment in lieu of an oath or declaration to meet the oath or declaration requirements of § 1.63. Section 3.31(h) is proposed to provide that an assignment cover sheet must contain a conspicuous indication of an intent to utilize the assignment as the required oath or declaration under § 1.63. For the importance of complying with this provision, see the discussion of § 1.63(c).

Section 3.71: Section 3.71(a) is proposed to be amended to be consistent with proposed § 1.33, which limits prosecution by juristic entities. The rule is also proposed to be amended to make it clear that conflicts between purported assignees are handled in accordance with § 3.73(c)(4).

Section 3.73: Section 3.73(b) is proposed to be amended to clarify who may sign a statement under § 3.73(b) in new paragraph (b)(2)(iii). Under § 3.73(b), an assignee must establish its ownership of an application to the satisfaction of the Director in order to request or take action in a patent or trademark matter. Current § 3.73(b)(2) specifies that the submission establishing ownership must either include a statement that the person signing the submission is authorized to act on behalf of the assignee (§ 3.73(b)(2)(i)) or be signed by a person who has apparent authority to sign on behalf of the assignee (§ 3.73(b)(2)(ii)).

Section 3.73(b)(2)(iii) is proposed to provide that a patent practitioner of record pursuant to § 1.32 could sign a statement under § 3.73(b). A patent practitioner can be considered “of record” for purposes of this section where the statement under § 3.73(b) is accompanied by a power of attorney that appoints the practitioner (see 37 CFR 3.73(b)(1)). Currently, a power of attorney to a patent practitioner to prosecute a patent application executed by the applicant or assignee of the entire interest does not make that practitioner an official of the assignee or empower the practitioner to sign the submission on behalf of the assignee. MPEP § 324, V. Patent practitioners who signed statements

under § 3.73(b) merely on the basis of having been appointed in a power of attorney document have done so improperly.

Section 3.73(b)(3) is proposed to clarify that any subsequent statement under § 3.73(b) must provide a complete chain of title. Current § 3.73(b)(1)(i) requires documentary evidence of a chain of title. The submission of a subsequent statement under § 3.73(b) that only identifies the latest “link” in the ownership chain would be incomplete and deemed insufficient to establish ownership of the application.

Section 3.73(c)(2) is proposed to be amended to better clarify how to identify to the Office the entire ownership interest. When establishing ownership of the application under § 3.73(b), one needs to be cognizant of the distinction between 100 percent ownership of the right, title, and interest in the invention from a single inventor and 100 percent ownership of the entire right, title, and interest in the invention from all of the inventors. This provision is applicable such as when one assignee owns 100 percent interest from one inventor and another assignee owns 100 percent interest from a different inventor. To comply with the requirement that the entire right, title, and interest be identified, both assignees would need to set forth their ownership interest by percentage (100 percent of the entire right, title, and interest) § 3.73(c)(2)(i), or both assignees would need to provide a statement that all parties owning an interest (without identification of percentage) have been identified, § 3.73(c)(2)(ii). Where a sole inventor assigns all rights to companies A and B, but the assignment does not specify percentages of ownership, the statement under § 3.73(b) would need to identify that companies A and

B together own 100 percent of the entire right, title, and interest without specifying individual percentages for company A and company B. Otherwise, the Office may refuse to accept the submission as an establishment of ownership.

Section 3.73(c)(3) is proposed to provide that, for a statement under § 3.73(b) from the prior application to have effect in a continuation or divisional application, or a continuation-in-part application with the same inventors or fewer, a copy of the statement under paragraph (b) of this section from the prior application for which benefit is claimed under 35 U.S.C. 120, 121, or 365(c), must be filed in the continuing application.

Section 3.73(c)(4) is proposed to be added to provide that, where two or more purported assignees file conflicting statements under paragraph (b) of this section, the Director will determine which, if any, purported assignee will be permitted to control prosecution of the application. As proposed, § 3.73(c)(4) provides in the rule the Office's practice for treating two or more conflicting statements under § 3.73(b), currently discussed in MPEP § 324, IX.

Sections 1.51, 1.53, 1.57, 1.78, 41.37, 41.67, and 41.110 are proposed to be amended to substitute references to 35 U.S.C. 112(a), (b), and (f), for the current references to 35 U.S.C. 112, first, second, and sixth paragraphs. Sections 1.45 and 1.48 are proposed to be amended to reflect the change regarding 35 U.S.C. 116. Section 1.173 is proposed to be amended to reflect the change regarding 35 U.S.C. 251. Sections 1.48, 1.324, 1.530, and 5.25 are proposed to be amended to delete the provisions pertaining to a lack

of deceptive intent. Sections 1.41, 1.46, 1.64, 1.76, 1.131, and 1.162 are proposed to be amended to delete the references to § 1.43. Section 1.76 is proposed to be amended to delete the reference to an inventor's citizenship to reflect the change regarding 35 U.S.C. 115.

Rulemaking Considerations:

A. Administrative Procedure Act: The primary changes proposed in this notice implement the inventor's oath or declaration provisions of the Leahy-Smith America Invents Act. This notice proposes changes to the rules of practice that concern the process for applying for a patent, namely, the statements required in the oath or declaration required by 35 U.S.C. 115 for a patent application (including the oath or declaration for a reissue application), the manner of presenting claims for priority to or the benefit of prior-filed applications under 35 U.S.C. 119, 120, 121, or 365, and the procedures for prosecution of an application by an assignee. The changes being proposed in this notice do not change the substantive criteria of patentability. These proposed changes involve rules of agency practice and procedure, and/or interpretive rules. See Bachow Commuc'ns., Inc. v. FCC, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); Inova Alexandria Hosp. v. Shalala, 244 F.3d 242, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims); Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive).

Accordingly, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law) and thirty-day advance publication is not required pursuant to 5 U.S.C. 553(d) (or any other law). See Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice.”) (quoting 5 U.S.C. 553(b)(A)). The Office, however, is publishing these changes for comment as it seeks the benefit of the public’s views on the Office’s proposed implementation of these provisions of the Leahy-Smith America Invents Act.

B. Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 et seq.) is required. See 5 U.S.C. 603.

In addition, for the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes proposed in this notice will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b). This notice proposes changes to the rules of practice to implement sections 4 and 20 of the Leahy-Smith America Invents Act, which provides changes to the inventor’s oath or declaration. The primary impact of the changes in this notice is the

streamlining of the requirements for oaths and declarations and the simplification of the filing of an application by the assignee when an inventor cannot or will not execute the oath or declaration. The burden to all entities, including small entities, imposed by these rules is a minor addition to that of the current regulations concerning the inventor's oath or declaration. The change to the manner of presenting claims for priority to or the benefit of prior-filed applications under 35 U.S.C. 119, 120, 121, or 365 will not have a significant economic impact on a substantial number of small entities as an application data sheet is easy to prepare and use, and the majority of patent applicants already submit an application data sheet with the patent application. The change to reissue oath or declaration will not have a significant economic impact on a substantial number of small entities as reissue is sought by the patentee for fewer than 1200 of the 1.2 million patents in force each year, and a reissue applicant already needs to know whether claims are being broadened to comply with the requirements of 35 U.S.C. 251. The change to the procedures for prosecution of an application by an assignee will not have a significant economic impact on a substantial number of small entities as it is rare for a juristic entity to attempt to prosecute a patent application pro se. Therefore, the changes proposed in this notice will not have a significant economic impact on a substantial number of small entities.

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. Executive Order 13563 (Improving Regulation and Regulatory Review): The Office has complied with Executive Order 13563. Specifically, the Office has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector and the public as a whole, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. Executive Order 13132 (Federalism): This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

F. Executive Order 13175 (Tribal Consultation): This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a

tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

G. Executive Order 13211 (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

H. Executive Order 12988 (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

I. Executive Order 13045 (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

J. Executive Order 12630 (Taking of Private Property): This rulemaking will not effect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

K. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.),

prior to issuing any final rule, the United States Patent and Trademark Office will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this notice are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this notice is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

L. Unfunded Mandates Reform Act of 1995: The changes proposed in this notice do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

M. National Environmental Policy Act: This rulemaking will not have any effect on the quality of environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

N. National Technology Transfer and Advancement Act: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions which involve the use of technical standards.

O. Paperwork Reduction Act: This rulemaking involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.). The collection of information involved in this rulemaking has been reviewed and previously approved by OMB under OMB Control Numbers 0651-0032 and 0651-0035. The primary impact of the changes in this notice is the streamlining of the requirements for oaths and declarations and the simplification of the filing of an application by the assignee when an inventor cannot or will not execute the oath or declaration. The Office is not resubmitting an information collection package to OMB for its review and approval, because the changes in this rulemaking do not change patent fees or change the information collection requirements (the estimated number of respondents, time per response, total annual respondent burden hours, or total annual respondent cost burden) associated with the information collections approved under OMB Control Numbers 0651-0032 and 0651-0035.

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information

subject to the requirements of the Paperwork Reduction Act, unless that collection of information displays a currently valid OMB control number.

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

37 CFR Part 3

Administrative practice and procedure, Patents, Trademarks

For the reasons set forth in the preamble, 37 CFR parts 1 and 3 are proposed to be amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

2. Section 1.1 is amended by revising paragraph (e) to read as follows:

§ 1.1 Addresses for non-trademark correspondence with the United States Patent and Trademark Office.

* * * * *

(e) Patent term extension. All applications for extension of patent term under 35 U.S.C. 156 and any communications relating thereto intended for the United States Patent and Trademark Office should be additionally marked “Mail Stop Hatch-Waxman PTE.” When appropriate, the communication should also be marked to the attention of a particular individual, such as where a decision has been rendered.

* * * * *

3. Section 1.4 is amended by revising paragraph (e) to read as follows:

§ 1.4 Nature of correspondence and signature requirements.

* * * * *

(e) Correspondence requiring a person’s signature and relating to payment by credit card in patent cases or registration to practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original handwritten signature personally signed in permanent dark ink or its equivalent by that person.

* * * * *

4. Section 1.31 is revised to read as follows:

§ 1.31 Applicant may be represented by one or more patent practitioners or joint inventors.

(a) An applicant for patent may file and prosecute his or her own case, or he or she may give a power of attorney to be represented by one or more patent practitioners or joint inventors, except that a juristic entity must be represented by a patent practitioner. Prosecution by a juristic entity is governed by § 3.71(a), and the taking of action by any assignee is governed by § 3.73.

(b) The United States Patent and Trademark Office cannot aid in the selection of a patent practitioner.

5. Section 1.32 is amended by adding new paragraphs (d) and (e) to read as follows:

§ 1.32 Power of attorney.

* * * * *

(d) A power of attorney from a prior application for which benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in a continuing application may have effect in the continuing application if the inventorship of the continuing application is the same as the prior application or one or more inventors from the prior application have been deleted in the continuing application, and if a copy of the power of attorney from the prior application is filed in the continuing application.

(e) If a power of attorney has been granted by all of the inventors and not an assignee, the addition of an inventor pursuant to § 1.48 results in the loss of that power of

attorney upon grant of the § 1.48 request, unless the added inventor provides a power of attorney consistent with the power of attorney provided by the other inventors. This provision does not preclude a practitioner from acting pursuant to § 1.34, if applicable.

6. Section 1.33 is amended by removing and reserving paragraph (b)(3), revising the introductory text of paragraph (a), and adding new paragraphs (f), (g), and (h) to read as follows:

§ 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

(a) Correspondence address and daytime telephone number. When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76 (b)(1) and 1.63 (c)(2)) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the Office's electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner, except as deemed necessary by the Director. If more than one correspondence address is specified in a single paper or in multiple papers submitted on

one day, the Office will select one of the specified addresses for use as the correspondence address and, if given, may select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who is authorized to change the correspondence address. The correspondence address may be changed as follows:

* * * * *

(b) * * *

(3) [Reserved]

* * * * *

(f) An assignee may only conduct prosecution of an application in accordance with §§ 1.31 and 3.71 of this chapter. Unless otherwise specified, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner.

(g) Where application papers from a prior application are used in a continuing application and the correspondence address was changed during the prosecution of the prior application, an application data sheet or separate paper identifying the updated correspondence address to be used for the continuing application must be submitted. Otherwise, the Office may not recognize the change of correspondence address effected during the prosecution of the prior application.

(h) A patent practitioner acting in a representative capacity whose correspondence address is the correspondence address of record in an application may change the correspondence address after the patent has issued, provided that the change of

correspondence address is accompanied by a statement that notice has been given to the patentee or owner.

7. Section 1.41 is amended by revising paragraphs (a)(3), (a)(4) and (c) to read as follows:

§ 1.41 Applicant for patent.

(a) * * *

(3) In a nonprovisional application filed without an oath or declaration as prescribed by § 1.63 or in a provisional application filed without a cover sheet as prescribed by § 1.51(c)(1), the name and residence of each person believed to be an actual inventor should be provided when the application papers pursuant to § 1.53(b) or § 1.53(c) are filed.

(4) The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the first submission of an executed declaration under PCT Rule 4.17(iv) or oath or declaration under § 1.497, except as provided in § 1.63(d). If neither an executed declaration under PCT Rule 4.17(iv) nor executed oath or declaration under § 1.497 is filed during the pendency of the national stage application, the inventorship is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92bis.

* * * * *

(c) Any person authorized by the applicant may physically or electronically deliver an application for patent and related correspondence, including fees, to the Office

on behalf of the inventor or inventors and provide a correspondence address pursuant to § 1.33(a), but an oath or declaration (§ 1.63) can only be made in accordance with § 1.64 and amendments and other papers must be signed in accordance with § 1.33(b).

* * * * *

8. Section 1.42 is revised to read as follows:

§ 1.42 When the inventor is deceased or legally incapacitated.

(a) In the case of the death or legal incapacity of the inventor, the legal representative (e.g., executor, administrator, guardian, or conservator) of the deceased or incapacitated inventor, the assignee, or a party to whom the inventor is under an obligation to assign the invention or party who otherwise shows sufficient proprietary interest in the matter may execute the oath or declaration under § 1.63, provided that the oath or declaration complies with the requirements of § 1.63(a) and (b) and identifies the inventor who is deceased or legally incapacitated. A party who shows sufficient proprietary interest in the matter executes the oath or declaration on behalf of the deceased or incapacitated inventor.

(b) A party to whom the inventor is under an obligation to assign the invention or a party who otherwise has sufficient proprietary interest in the matter taking action under this section must do so by way of a petition that is accompanied by the fee set forth in § 1.17(g) and a showing, including proof of pertinent facts, either that:

(1) The deceased or incapacitated inventor is under an obligation to assign the invention to the party; or

(2) The party has sufficient proprietary interest in the matter to execute the oath or declaration pursuant to § 1.63 on behalf of the deceased or incapacitated inventor and that such action is necessary to preserve the rights of the parties.

(c) If the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative or assignee upon proper intervention pursuant to this section.

9. Section 1.43 is removed and reserved.

§ 1.43 [Reserved]

10. Section 1.47 is revised to read as follows:

§ 1.47 When an inventor refuses to sign or cannot be reached.

(a) If an inventor or legal representative thereof (§ 1.42) refuses to execute the oath or declaration under § 1.63, or cannot be found or reached after diligent effort, the assignee of the nonsigning inventor, a party to whom the inventor is obligated to assign the invention, or a party who otherwise shows sufficient proprietary interest in the matter may execute the oath or declaration under § 1.63. A party who shows sufficient proprietary interest in the matter executes the oath or declaration on behalf of the nonsigning inventor.

(b) If a joint inventor or legal representative thereof (§ 1.42) refuses to execute the oath or declaration under § 1.63 or cannot be found or reached after diligent effort, the

remaining inventor(s) may execute the oath or declaration under § 1.63 on behalf of himself or herself and the nonsigning inventor.

(c) Any oath or declaration executed pursuant to this section must comply with the requirements of §1.63(a) and (b) and be accompanied by a petition that:

(1) Includes the fee set forth in § 1.17(g);

(2) Identifies the nonsigning inventor, and includes the last known address of the nonsigning inventor;

(3) States either the inventor or legal representative cannot be reached after a diligent effort was made, or has refused to execute the oath or declaration under § 1.63 when presented with a copy of the application papers, with proof of the pertinent facts; and

(4) For a party to whom the nonsigning inventor is under an obligation to assign the invention, or has sufficient proprietary interest in the matter acting under paragraph (a) of this section, a showing, including proof of pertinent facts, either that:

(i) The nonsigning inventor is under an obligation to assign the invention to the party; or

(ii) The party has sufficient proprietary interest in the matter to execute the oath or declaration pursuant to § 1.63 on behalf of the nonsigning inventor and that such action is necessary to preserve the rights of the parties.

(d) The Office will publish notice of the filing of the application in the Official Gazette, and may send notice of filing of the application to the nonsigning inventor at the address(es) provided in the petition under this section. The Office may dispense with this

notice provision in a continuing application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

(e) A nonsigning inventor or legal representative may subsequently join in the application by submitting an oath or declaration under § 1.63. The submission of an oath or declaration by a nonsigning inventor or legal representative after the grant of a petition under this section will not permit the nonsigning inventor or legal representative to revoke or grant a power of attorney.

11. Section 1.48 is amended by revising the section heading and adding new paragraph (k) to read as follows:

§ 1.48 Correction of inventorship in a patent application, other than a reissue application.

* * * * *

(k) National stage application under 35 U.S.C. 371. The procedure set forth in paragraph (a) of this section for correcting an error in inventorship is also applicable to international applications entering the national stage under 35 U.S.C. 371 prior to becoming nonprovisional applications (§ 1.9(a)(3)), and to correct an error in the inventive entity set forth in an executed declaration submitted under PCT Rule 4.17(iv).

12. Section 1.53 is amended by revising paragraph (f)(4) to read as follows:

§ 1.53 Application number, filing date, and completion of application.

* * * * *

(f) * * *

(4) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part applications under paragraph (b) of this section. See § 1.63(d) concerning the submission of a copy of the oath or declaration from the prior application for a continuing application under paragraph (b) of this section.

* * * * *

13. Section 1.55 is amended by revising the introductory text of paragraph (a)(1)(i), the introductory text of paragraph (c), and paragraph (d)(1)(ii) to read as follows:

§ 1.55 Claim for foreign priority.

(a) * * *

(1)(i) In an original application filed under 35 U.S.C. 111(a), the claim for priority must be presented in an application data sheet (§ 1.76(b)(6)) or a supplemental application data sheet (§ 1.76(c)) during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country

(or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply in an application under 35 U.S.C. 111(a) if the application is:

* * * * *

(c) Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) not presented in an application data sheet (§ 1.76(b)(6)) or a supplemental application data sheet (§ 1.76(c)) within the time period provided by paragraph (a) of this section is considered to have been waived. If a claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) is presented after the time period provided by paragraph (a) of this section, the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country (or intellectual property authority), and the day, month, and year of its filing was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) must be accompanied by:

* * * * *

(d)(1) * * *

(ii) The foreign application is identified in an application data sheet (§ 1.76(b)(6)) or a supplemental application data sheet (§ 1.76(c)); and

* * * * *

14. Section 1.63 is revised to read as follows:

§ 1.63 Oath or declaration.

(a) A nonprovisional application for patent filed under 35 U.S.C. 111(a) or which entered the national stage under 35 U.S.C. 371 shall include, or be amended to include, an oath or declaration. The oath or declaration under this section must:

(1) Be executed (i.e., signed) in accordance with either § 1.66 or § 1.68;

(2) Identify each inventor by his or her full name without any abbreviation (except for a middle initial);

(3) Identify the application to which it is directed;

(4) Include a statement that the person executing the oath or declaration believes the named inventor or joint inventors to be the original inventor or original joint inventors of the claimed invention in the application for which the oath or declaration is being submitted;

(5) State that the application was made or was authorized to be made by the inventor;

(6) State that the person making the oath or declaration has reviewed and understands the contents of the application for which the oath or declaration is being submitted, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and

(7) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

(b) Unless such information is supplied on an application data sheet in accordance with § 1.76, the oath or declaration must also identify for each inventor a mailing address

where the inventor customarily receives mail, and residence, if the inventor lives at a location different from the mailing address.

(c)(1) An assignment may also include the oath or declaration required by this section if:

(i) The assignment contains the information and statements required under paragraphs (a) and (b) of this section; and

(ii) A copy of the assignment is filed in the application and recorded as provided for in part 3 of this chapter.

(2) Any reference to an oath or declaration under § 1.63 includes an assignment as provided for in this paragraph.

(d)(1) A newly executed inventor oath or declaration under § 1.63 is not required under § 1.51(b)(2) and § 1.53(f) or § 1.497(a) in an application that claims the benefit under 35 U.S.C. 120, 121, or 365(c) in compliance with § 1.78 of an earlier-filed application, provided that:

(i) An executed oath or declaration in compliance with this section was filed in the earlier-filed application;

(ii) A copy of such oath or declaration, showing the signature or an indication thereon that it was executed, is submitted in the continuing application; and

(iii) Any new inventors named in the continuing application provide an executed oath or declaration in compliance with this section.

(2) If applicable, the copy of the executed oath or declaration submitted under this paragraph must be accompanied by a statement signed pursuant to § 1.33(b) requesting

the deletion of the name or names of the person or persons who are not inventors in the continuing application.

(3) If the earlier-filed application has been accorded status via a petition under § 1.42 or § 1.47, the copy of the executed oath or declaration must be accompanied by a copy of the decision granting the petition in the earlier-filed application, unless all inventors or legal representatives subsequently joined in the earlier-filed application. If one or more nonsigning inventor(s) or legal representative(s) subsequently joined in the earlier-filed application, the copy of the executed oath or declaration must be accompanied by a copy of the executed oath or declaration filed by the inventor or legal representative to join in the application.

(e) An oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1) will be placed in the file record of the application or patent, but may not be reviewed by the Office. Any request for correction of the named inventorship must comply with § 1.48 in an application and § 1.324 in a patent.

15. Section 1.64 is amended by revising paragraph (b) to read as follows:

§ 1.64 Person making oath or declaration.

* * * * *

(b) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.47, or 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is required to state. If the person signing the oath or declaration is the

legal representative of a deceased or legally incapacitated inventor, the oath or declaration shall also state that the person is a legal representative and, unless such information is supplied on an application data sheet in accordance with § 1.76, the residence and mailing address of the legal representative.

16. Section 1.67 is revised to read as follows:

§ 1.67 Noncompliant oath or declaration.

(a) Where an oath or declaration does not comply with a requirement of 35 U.S.C. 115, or a requirement of § 1.63 or 1.162, the Office may require, or the inventors and applicants may submit, an oath or declaration meeting the requirements of § 1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier-filed oath or declaration.

(1) Deficiencies or inaccuracies relating to all the inventors or applicants (§ 1.42 or § 1.47) may be corrected with an oath or declaration in compliance with 35 U.S.C. 115 and § 1.63 or 1.162 signed by all the inventors or applicants.

(2) Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) (§ 1.42 or § 1.47) may be corrected with an oath or declaration in compliance with 35 U.S.C. 115 and § 1.63 or 1.162 identifying the entire inventive entity but signed only by the inventor(s) or applicant(s) to whom the error or deficiency relates.

(3) Deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(b) in an oath or declaration may be corrected with a supplemental application data sheet in accordance with § 1.76.

(b) No new matter may be introduced into a nonprovisional application after its filing date, even if an oath or declaration is filed to correct deficiencies or inaccuracies present in the earlier-filed oath or declaration.

17. Section 1.76 is amended by revising paragraphs (a), (c), and (d)(1) to read as follows:

§ 1.76 Application data sheet.

(a) Application data sheet: An application data sheet is a sheet or sheets, that may be submitted in a provisional application, a nonprovisional application, or an international application entering the national stage under 35 U.S.C. 371, and must be submitted to claim priority to or the benefit of a prior-filed application under 35 U.S.C. 119, 120, 121, or 365. An application data sheet contains bibliographic data, arranged in a format specified by the Office. An application data sheet must be titled “Application Data Sheet” and must contain all of the section headings listed in paragraph (b) of this section, with any appropriate data for each section heading. If an application data sheet is provided, the application data sheet is part of the provisional or nonprovisional application for which it has been submitted.

* * * * *

(c) Supplemental application data sheets. Supplemental application data sheets:

(1) May be supplied only after filing of the application, regardless of whether an application data sheet under paragraph (a) of this section was submitted on filing, and until payment of the issue fee, either to correct or update information in a previously

submitted application data sheet, or an oath or declaration under § 1.63 or § 1.67, except that inventorship changes are governed by § 1.48, and correspondence changes are governed by § 1.33(a); and

(2) Must be titled “Supplemental Application Data Sheet,” include all of the section headings listed in paragraph (b) of this section, include all appropriate data for each section heading, be signed in accordance with § 1.33(b), and identify the information that is being changed, with underlining for insertions of text, and strike-through or brackets for deletions of text.

(d) * * *

(1) The most recent submission will govern with respect to inconsistencies as between the information provided in an application data sheet, an amendment to the specification, a designation of a correspondence address, or by a § 1.63 or § 1.67 oath or declaration, except that the most recent oath or declaration (§ 1.63 or § 1.67) will govern with respect to the naming of inventors (§ 1.41(a)(1)), and that the most recent application data sheet will govern with respect to foreign priority (§ 1.55) or domestic benefit (§ 1.78) claims;

* * * * *

18. Section 1.78 is amended by revising paragraphs (a)(2)(iii) and (a)(5)(iii) to read as follows:

§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a) * * *

(2) * * *

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)) or a supplemental application data sheet (§ 1.76(c)).

* * * * *

(5) * * *

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)) or a supplemental application data sheet (§ 1.76(c)).

* * * * *

19. Section 1.172 is revised to read as follows:

§ 1.172 Applicants.

(a) A reissue applicant must submit an oath or declaration accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent.

(b) Oath or declaration:

(1) Nonbroadening reissues: If the application does not seek to enlarge the scope of the claims of the original patent, the oath or declaration must be signed by:

(i) The inventor or inventors, including the legal representatives of deceased or legally incapacitated inventors or a § 1.47 applicant for a nonsigning inventor;

(ii) An assignee of the entire interest; or

(iii) All partial assignees together with all inventors who have not assigned their rights, including the legal representatives of deceased or legally incapacitated inventors or a § 1.47 applicant for a nonsigning inventor.

(2) Broadening reissues: If the applicant seeks to enlarge the scope of the claims of the original patent, the oath or declaration must be signed by:

(i) The inventor or inventors, including the legal representatives of deceased or legally incapacitated inventors or a § 1.47 applicant for a nonsigning inventor; or

(ii) For a reissue application filed on or after September 16, 2012, the assignee of the entire interest where the application for the original patent was filed by the assignee of the entire interest (i.e., the oath or declaration was executed by the assignee under § 1.42 or § 1.47).

(c) Assignee ownership: All assignees consenting to the reissue must establish their ownership in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(b).

(d) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

20. Section 1.175 is amended by revising paragraphs (a), (b), (c), and (e), and adding paragraph (f), to read as follows:

§ 1.175 Reissue oath or declaration.

(a) The reissue oath or declaration, in addition to complying with the requirements of § 1.63, must also specifically identify at least one error pursuant to 35

U.S.C. 251 being relied upon as the basis for reissue and state that the applicant believes the original patent to be wholly or partly inoperative or invalid by reason of each one of the following reasons that are applicable:

(1) A defective specification or drawing;

(2) The patentee claiming more than the patentee had the right to claim in the patent; or

(3) The patentee claiming less than the patentee had the right to claim in the patent and identify a broadened claim and a broadened portion of the specification if a change thereto is the basis for the claim broadening;

(b) A claim broadened in any respect must be treated and identified as a broadened claim pursuant to paragraph (a)(3) of this section.

(c) Where all errors previously identified in the reissue oath or declaration pursuant to paragraph (a) of this section are no longer being relied upon as the basis for reissue, a new error currently being relied upon as the basis for reissue must be identified in a reissue oath or declaration under this section, which statement need only address the new error.

* * * * *

(e) Continuing reissue applications:

(1) Where a continuing reissue application replaces a prior reissue application, the requirement for a reissue oath or declaration pursuant to § 1.172 may be satisfied by a copy of the reissue oath or declaration from the prior reissue application it replaces.

(2) Where a continuing reissue application does not replace a prior reissue application, the requirement for a reissue oath or declaration pursuant to § 1.172 may be satisfied by:

(i) A newly executed reissue oath or declaration that identifies at least one error in the original patent which has not been corrected by a prior reissue application; or

(ii) A copy of the reissue oath or declaration from a prior reissue application within the chain of the benefit claim, accompanied by a statement that explains either that an identified error was not corrected in a prior reissue application, or how an identified error is currently being corrected in a manner different than in a prior reissue application.

(f) A reissue oath or declaration filed at any time pursuant to 35 U.S.C. 115(h)(1) will be placed in the file record of the reissue application, but may not be reviewed by the Office.

21. Section 1.311 is amended by adding new paragraph (c) to read as follows:

§ 1.311 Notice of allowance.

* * * * *

(c) Where an assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter has filed an application under §§ 1.42, or 1.47, the applicant must notify the Office of any change in ownership of the application no later than payment of the issue fee. The Office will treat the absence of such a notice as an indication that there has been no change in ownership of the application.

22. Section 1.497 is revised to read as follows:

§ 1.497 Oath or declaration under 35 U.S.C. 371(c)(4).

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to § 1.495, and a declaration in compliance with this section has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26ter.1, the applicant must file an oath or declaration in accordance with § 1.63.

(b) An oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4) and § 1.495(c) for purposes of entering the national stage under 35 U.S.C. 371 if it:

(1) Is executed in accordance with either §§ 1.66 or 1.68;

(2) Identifies the application to which it is directed;

(3) Identifies each inventor;

(4) States that the person executing the oath or declaration believes the named inventor or inventors to be the original inventor or an original joint inventor of a claimed invention in the application;

(5) States that the application was made or was authorized to be made by the inventor; and

(6) Where the oath or declaration is not made by the inventor, complies with the applicable requirements of §§ 1.42 and 1.47.

(c) If the oath or declaration meeting the requirements of § 1.497(b) does not also meet the requirements of § 1.63, an oath or declaration in compliance with § 1.63 or a supplemental application data sheet will be required in accordance with § 1.67.

PART 3--ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

23. The authority citation for part 3 continues to read as follows:

Authority: 15 U.S.C. 1123; 35 U.S.C. 2(b)(2).

24. Section 3.31 is amended by adding new paragraph (h) to read as follows:

§ 3.31 Cover sheet content.

* * * * *

(h) The assignment cover sheet required by § 3.28 must contain a conspicuous indication of an intent to utilize the assignment as the required oath or declaration under § 1.63 of this chapter.

25. Section 3.71 is amended by revising paragraph (a) to read as follows:

§ 3.71 Prosecution by assignee.

(a) Patents — conducting of prosecution on behalf of assignee. Subject to the requirements of §§ 1.31 and 1.33(f), one or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section,

conduct prosecution of a national patent application or a reexamination proceeding to the exclusion of either the inventive entity or the assignee(s) previously entitled to conduct prosecution. Conflicts between purported assignees are handled in accordance with § 3.73(c)(4).

* * * * *

26. Section 3.73 is amended by revising the section heading, paragraphs (b)(2)(ii) and (c)(2), and adding new (b)(2)(iii), (b)(3), (c)(3) and (c)(4) to read as follows:

§ 3.73 Establishing right of assignee to request or take action in a trademark or patent matter.

* * * * *

(b) * * *

(2) * * *

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee; or

(iii) Being signed by a patent practitioner of record pursuant to § 1.32 of this chapter.

(3) In any one application or proceeding, a subsequent statement must provide a complete chain of title.

(c) * * *

(2) If the submission is by an assignee of less than the entire right, title, and interest (e.g., more than one assignee exists), the Office may refuse to accept the submission as an establishment of ownership unless:

(i) Each assignee establishes the extent (by percentage) of its ownership interest, so as to account for the entire right, title, and interest in the application or patent by all parties including inventors; or

(ii) Each assignee submits a statement identifying the parties including inventors who together own the entire right, title, and interest and stating that all the identified parties own the entire right, title, and interest.

(3) A statement under paragraph (b) of this section from a prior application for which benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in a continuing application may have effect in the continuing application if the inventorship of the continuing application is the same as the prior application or one or more inventors from the prior application have been deleted in the continuing application, and a copy of the statement under paragraph (b) of this section from the prior application is filed in the continuing application.

(4) Where two or more purported assignees file conflicting statements under paragraph (b) of this section, the Director will determine which, if any, purported assignee will be permitted to control prosecution of the application.

Date: December 30, 2011

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

[FR Doc. 2011-33815 Filed 01/05/2012 at 8:45 am; Publication Date: 01/06/2012]